No. 91-T35

Supreme Court, U.S.
FILED
JUL 24 1991
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Petitioner,

v.

MARIO CUOMO, Ind., and as Governor of the State of New York; THEODORE M. BLACK, Ind., and as Chancellor, Board of Regents of the University of the State of New York; WILLARD A. GENRICH, Ind., and as Vice Chancellor, Board of Regents of the University of the State of New York; KENNETH B. CLARK, HAROLD E. NEWCOMB, EMLYN I. GRIFFITH, MARY ALICE KENDALL, JORGE L. BATISTA, LOUIS E. YAVNER, LAURA BRADLEY CHODOS, MARTIN C. BARELL, JOSEPH R. BONGIORNO, LOUISE P. MATTEONI, J. EDWARD MEYER, ARLENE B. REED-DELANEY, R. CARLOS CARBALLADA, Ind., and as Members of the Board of Regents of the University of the State of New York; GORDON M. AMBACH, Ind., and as Commissioner of Education, the University of the State of New York; and ROBERT ABRAMS, Ind., and as Attorney General,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Fed. R. App. P. (3)(c) provides that a "notice of appeal shall specify the party or parties taking the appeal." This case presents the question, on which the circuits are in conflict, whether that Rule is satisfied by a notice of appeal that states, under a short-form caption, that the appeal is being taken by "the defendants in the above matter" but does not identify any particular appellant.

PARTIES TO THIS PROCEEDING

All parties to this proceeding are identified in the caption of this case. Petitioner Association of American Medical Colleges is a nonprofit corporation that does not have any parent company or subsidiaries.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

No. 91-

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Petitioner,

v.

MARIO CUOMO, Ind., and as Governor of the State of New York; THEODORE M. BLACK, Ind., and as Chancellor, Board of Regents of the University of the State of New York; WILLARD A. GENRICH, Ind., and as Vice Chancellor, Board of Regents of the University of the State of New York; KENNETH B. CLARK, HAROLD E. NEWCOMB, EMLYN I. GRIFFITH, MARY ALICE KENDALL, JORGE L. BATISTA, LOUIS E. YAVNER, LAURA BRADLEY CHODOS, MARTIN C. BARELL, JOSEPH R. BONGIORNO, LOUISE P. MATTEONI, J. EDWARD MEYER, ARLENE B. REED-DELANEY, R. CARLOS CARBALLADA, Ind., and as Members of the Board of Regents of the University of the State of New York; GORDON M. AMBACH, Ind., and as Commissioner of Education, the University of the State of New York; and ROBERT ABRAMS, Ind., and as Attorney General,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

---

PETITION FOR A WRIT OF CERTIORARI

The Association of American Medical Colleges ("AAMC") hereby petitions for a writ of certiorari to the United States Court of Appeals for the Second Circuit.

OPINIONS BELOW

The opinion of the court of appeals on the merits (App. B) is reported at 928 F.2d 519. The opinion of the court of appeals denying AAMC's motion to dismiss the appeal for lack of jurisdiction (App. C) is reported at 913 F.2d 55. The opinion of the district court from which the appeal was taken (App. D) is reported at 728 F. Supp. 873. The opinion of the district court awarding preliminary injunctive relief (App. F) is reported at 482 F. Supp. 1358.

JURISDICTION

The judgment of the court of appeals was entered on March 12, 1991. A timely petition for rehearing was denied on April 26, 1991 (App. G). This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1) (1988).

FEDERAL RULE INVOLVED

Federal Rule of Appellate Procedure 3(c) provides, in pertinent part, as follows:

> The notice of appeal shall specify the party or parties taking the appeal. . . . An appeal shall not be dismissed for informality of form or title of the notice of appeal.

STATEMENT

Petitioner AAMC brought this action against 18 named officers of the State of New York in 1979, seeking among other relief, a declaratory judgment that portions of New York's Standardized Testing Act, N.Y. Educ. Law §§ 340-348, are preempted by federal copyright law and infringe AAMC's copyrights. The action was filed in the United States District Court for the Northern District of New York, where jurisdiction rested on 28 U.S.C. §§ 1331, 1338(a) and 1343(3). *See* App. F at 63a. In 1990, the district court granted AAMC's motion for summary judgment and entered final judgment in favor of AAMC. Apps. D and E at 59a, 60a.

A timely notice of appeal, captioned "Association of American Colleges v. Mario Cuomo, Governor of the State of New York, *et al.*," was filed with the clerk of the district court. App. H at 86a. The body of the notice read as follows:

> PLEASE TAKE NOTICE that the defendants in the above matter hereby appeal to the United States Court of Appeals for the Second Circuit, from the final order of judgment entered by the Court on February 13, 1990.

Id. The notice did not identify the specific defendants on whose behalf the notice was being filed, either by name or in any other manner.

Relying on *Torres v. Oakland Scavenger Co.*, 487 U.S. 312 (1988), AAMC moved to dismiss the appeal on the ground that the notice did not satisfy the specificity requirements of Fed. R. App. P. 3(c). The Second Circuit denied AAMC's motion, holding that "the phrase 'the defendants in the above matter hereby appeal' was the functional equivalent of naming each and every defendant in this action." App. C at 25a.

On the merits, the court of appeals agreed with much of the district court's analysis. *See* App. B at 9a-16a. Nevertheless, it reversed and remanded on the ground that a genuine issue of material fact precluded summary judgment. *Id.* at 15a-16a.

REASONS FOR GRANTING THE WRIT

The Second Circuit's jurisdictional ruling directly conflicts with decisions in at least four other circuits. If this case had been pending in the Seventh Circuit, the entire appeal would have been dismissed. *See Pride v. Venango River Corp.*, 916 F.2d 1250, 1251 (7th Cir. 1990), *cert. denied*, 111 S. Ct. 1696 (1991). The First, Fifth, and Sixth Circuits would have dismissed the appeal at least as to all defendants other than the one defendant named in the caption of the notice of appeal. *See Marin-Piazza v. Aponte-Roque*, 873 F.2d 432, 433 n.1 (1st Cir. 1989); *Resolution Trust Corp. v. Sonny's Old Land Corp.*, —— F.2d ——, 1991 WL 128583 (5th Cir. July 17, 1991); *Minority Employees of Tennessee Dept. of Employment Sec., Inc. v. State of Tennessee, Dept. of Employment Sec.*, 901 F.2d 1327, 1330, 1335-36 (6th Cir. 1990) (en banc), *cert. denied sub nom. Davis v. Tennessee Dept. of Employment Sec.*, 111 S. Ct. 210 (1990). This Court should grant certiorari in order to resolve this conflict and clarify the specificity requirement of Fed. R. App. P. 3(c). On a question of such basic and everyday importance as the jurisdictionally necessary content of a notice of appeal, a clear and uniform rule is essential.

Review is warranted because the courts of appeals fundamentally disagree concerning how this Court's decision in *Torres* should be implemented. In *Torres* the Court held that to confer jurisdiction a notice of appeal must give "fair notice of the specific individual or entity seeking to appeal." 487 U.S. at 318. The Court ruled, in particular, that "use of the phrase 'et al.,' which literally means 'and others,' utterly fails to provide such notice." *Id.* In short, "vague designation[s]" are insufficient. *Id.*

Nevertheless, certain circuits, including the court below, continue to allow the use of vague generic descriptions in notices of appeal. In addition, the circuits are

split on whether an appellate court may look to the caption of the notice to resolve ambiguity. This case affords an opportunity to resolve these matters once and for all. Clarification will assist practitioners, ensure fairness and uniformity of result, and conserve judicial resources.

1. *The decision below directly conflicts with decisions in the First, Fifth, Sixth, and Seventh Circuits.* The split in the circuits may be demonstrated by comparing the notice of appeal in this case with the notices in *Marin-Piazza*, *Sonny's Old Land*, *Minority Employees*, and *Pride* (emphasis supplied):

AAMC

> PLEASE TAKE NOTICE THAT *the defendants in the above matter* hereby appeal to the United States Court of Appeals for the Second Circuit. . . .

Marin-Piazza

> [*T*]*he codefendants in this action* hereby appeal. . . .

Sonny's Old Land

> Notice is hereby given that *the defendants in this action*, hereby appeal.

Minority Employees

> Now come *plaintiffs in the above case* and appeal to the United States Court of Appeals for the Sixth Circuit. . . .

Pride

> Come now *the plaintiffs by their attorney*, Amiel Cueto, and . . . hereby notices that *plaintiffs* are appealing to the U.S. Seventh Circuit Court of Appeals. . . .

As can be seen, all five notices use generic phrases to designate the appealing parties. Furthermore, the captions of all five notices name only one plaintiff or defendant, followed by *et al.* Despite these similarities, the five courts reached three distinctly different results.

In *Marin-Piazza* the First Circuit held that the phrase "the codefendants in this action" does not satisfy Fed. R. App. P. 3(c). 873 F.2d at 432-33. The court allowed the appeal, however, of the one defendant named in the caption.

The Fifth Circuit in *Sonny's Old Land* similarly allowed the appeal of only the single defendant named in the caption. The court rejected the language used in the body of the notice ("the defendants in this action") because the court could not "say with any degree of certainty which of the six other defendants below join in this appeal." —— F.2d ——, 1991 WL 128583 at 2.

Sitting en banc, the Sixth Circuit held in *Minority Employees* that the generic phrase "plaintiffs in the above case" does not satisfy Fed. R. App. P. 3(c). 901 F.2d at 1335. In so holding, the court expressly overruled *Ford v. Nicks*, 866 F.2d 865 (6th Cir. 1989), which had accepted use of the phrase "the defendants." *See* 901 F.2d at 1330, 1332. Thus, in the Sixth Circuit, neither "defendants" nor "the defendants" passes muster under Fed. R. App. P. 3(c). The Sixth Circuit dismissed the appeal in *Minority Employees* as to the unnamed plaintiffs but heard the appeal of the one plaintiff named in the caption.[1]

The use of a generic description—"the plaintiffs"—also was rejected by the Seventh Circuit in *Pride*. Unlike the First, Fifth and Sixth Circuits, however, the

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[1] The Sixth Circuit noted in *Minority Employees* that, "[p]lainly after *Torres*, the safest way of securing an appeal is for the party or parties seeking to appeal to state in the *body* of the notice of appeal the name of each and every party taking the appeal." 901 F.2d at 1335 (original emphasis). Nevertheless, the court concluded that the caption of the notice could be consulted in determining appellate jurisdiction. *Id.* at 1335-36. It did so "reluctantly," however, and held that a caption will rescue an otherwise deficient notice "only where the caption is not inconsistent with the body of the notice. Any ambiguity will defeat the notice." *Id.* at 1336.

Seventh Circuit dismissed the entire appeal, holding that the defect in the body of the notice could not be cured, even in part, by the identification, in the caption, of at least one potential appellant. 916 F.2d at 1253.

The Second Circuit's holding in this case conflicts with all of these decisions. The court below held that the generic phrase "the defendants in the above matter" satisfies Fed. R. App. P. 3(c) and thus serves to designate each and every defendant as a party to the appeal.[2]

Of these three variant approaches adopted by the courts of appeals, only that of the Seventh Circuit is faithful to the text and purpose of Fed. R. App. P. 3(c). As this Court noted in *Torres*, the rule's specificity requirement is designed to provide both certitude and fair notice regarding the identity of the parties taking the appeal. 487 U.S. at 318. If courts accept notices of appeal using vague designations and generic phases such as "defendants" or "the defendants," this objective will not be met. Generic phrasing can be particularly problematic in a complex case involving many parties, some of whom may have been joined, substituted or dismissed subsequent to the filing of the original complaint. *See, e.g., Storage Technology Corp. v. U.S. Dist. Court for the Dist. of Colorado*, 934 F.2d 244, 248 (10th Cir. 1991).

The Seventh Circuit's refusal to consider the caption of the notice of appeal also furthers the purpose of Fed. R. App. P. 3(c). Neither the opposing party nor the court can assume that the particular party named in a short-

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[2] The Ninth Circuit, like the Second Circuit, allows such generic phrases. App. J at 91a. For example, in *Cammack v. Waihee*, 932 F.2d 765, 768 (9th Cir. 1991), the notice of appeal stated that "Plaintiffs above-named hereby appeal." The Ninth Circuit noted that "[t]he compound adjective 'above-named' apparently refer[red] to the notice's caption," *id.*, and that only one individual was named in the caption, followed by *et al.* Nevertheless, the court ruled that the notice was "sufficiently clear to alert the court and defendants that all plaintiffs are seeking to appeal." *Id.* at 769.

form caption is actually an appellant. Generally, the party named in the caption is simply the first party named in the complaint, and that party may not even be appealing. *See Santos-Martinez v. Soto-Santiago*, 863 F.2d 174, 175-76 (1st Cir. 1988) (party named in short-form caption was not in fact appealing; entire appeal dismissed in light of *Torres*). Indeed, because notices of appeal are filed in the district court, the appearance of the initial party's name in the caption probably reflects nothing more than compliance with Fed. R. Civ. P. 10(a). *See* App. I at 88a.

In the present case, neither the body of the notice read alone, nor the body read together with the caption, provide the certitude required by *Torres*. Confirming the insufficiency of the defendants' notice can thus clarify *Torres* and standardize the circuits' divergent treatment of generic phrases [3] and captions.[4]

2. *The issue is important.* There has been an unproductive explosion of appellate litigation over the specificity requirement of Fed. R. App. P. 3(c). In the three years since *Torres* was decided, the adequacy of notices of appeal has been an issue in at least 145 reported cases in the courts of appeals.[5] In at least 13 cases, a petition for certiorari has been filed raising a *Torres*-related issue. *See* App. J at 95a. Clarification is needed to prevent the additional wasteful expenditure of

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[3] *Compare* App. J at 91a (cases that have allowed the use of generic phrases), *and id.* at 92a (cases that have allowed the use of modified generic phrases), *with id.* at 90a (cases that have not allowed the use of generic phrases).

[4] *Compare* App. J at 93a (cases in which the caption has been consulted), *with id.* (cases in which the court has held that the caption may not be consulted).

[5] This number is based on computer searches for post-*Torres* cases that have construed Rule 3(c)'s specificity requirement. Additional, unpublished decisions no doubt exist. *See* App. J at 89a.

judicial and party resources on what should be a straightforward, bright-line jurisdictional rule.[6]

In grappling with this issue, the circuits have fallen into disarray. Most circuits insist upon more than the catch-all "*et al.*" as a means of identifying the parties taking an appeal. Some, however, do not, at least if there are only two parties to the appeal, or the named party is a parent and the *al.* refers to his or her children, or the named party is a class representative and the *al.* refers to the other members of the class. *See* App. J at 89a. Also, if the *al.* is replaced by *ux.*, the notice of appeal is adequate. *Id.* at 90a. Most circuits also hold that generic phrases such as "the defendants" or, simply, "defendants" do not satisfy Fed. R. App. 3(c). *See id.* at 90a. In the Second and Ninth Circuits, however, phrases like "the defendants" are usually, but not always, sufficient. *See id.* at 91a, 92a. In other circuits, a generic phrase may be adequate if it is modified by certain key words. *See id.* at 92a. Even in those circuits, however, the notice of appeal may still fail if the caption does not include the phrase "*et al.*" *Id.* at 91a. And some circuits have looked to documents other than the notice of appeal to identify the appellants. *Id.* at 94a.

This Court should restore order to this area of the law by granting review in this case and explicitly endorsing

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[6] The waste of judicial resources is graphically illustrated by a series of Sixth and Ninth Circuit cases addressing the jurisdictional significance of the definite article "the" in the phrase "the defendants." *See Ford v. Nicks*, 866 F.2d 865, 869-70 (6th Cir.) (phrase "the defendants" satisfies Rule 3(c)), *reh'g denied* (6th Cir. 1989), *overruled*, *Minority Employees*, 901 F.2d at 1330 (en banc) (addressing the notice of appeal filed in that case for a *fourth* time); *and Zamora v. Hart*, 883 F.2d 1025 (9th Cir. 1989) (TABLE, TEXT IN WESTLAW) (unlike the phrase "the defendants," phrase "defendants" does not satisfy Rule 3(c)), *modified*, 902 F.2d 42 n.1 (9th Cir. 1990) (TABLE, TEXT IN WESTLAW) (original panel reversed its prior position and held that the phrase "defendants" does satisfy Rule 3(c) (citing *National Center for Immigrants' Rights v. I.N.S.*, 892 F.2d 814 (9th Cir. 1989)).

the clear-cut reading of Fed. R. App. P. 3(c) that is implied by *Torres* and has been adopted by the Seventh Circuit in *Pride*. That reading of the rule best furthers the goals of certainty and predictability. Its endorsement by this Court will ensure that appellate courts and parties need not continue to waste valuable time and resources addressing the adequacy of notices of appeal.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, on the 12th day of March, one thousand nine hundred and ninety-one.

Present: HON FRANK X. ALTIMARI
HON. J. DANIEL MAHONEY
Circuit Judges,
HON. T.F. GILROY DALY
District Judge *

90-7269, -7309

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff-Appellee,
Cross-Appellant,

-against-

MARIO CUOMO, Ind., and as Governor of the State of New York; THEODORE M. BLACK, Ind., and as Chancellor, Board of Regents of the University of the State of New York; WILLARD A. GENRICH, Ind., and as Vice Chancellor, Board of Regents of the University of the State of New York; KENNETH B. CLARK, HAROLD E. NEWCOMB, EMLYN I. GRIFFITH, MARY ALICE KENDALL, JORGE L. BATISTA, LOUIS E. YAVNER, LAURA BRADLEY CHODOS, MARTIN C. BARELL, JOSEPH R. BONGIORNO, LOUISE P. MATTEONI, J. EDWARD MEYER, ARLENE B. REED-DELANEY, R. CARLOS CARBALLADA, Ind., and as

Members of the Board of Regents of the University of the State of New York, GORDON M. AMBACH, Ind., and as Commissioner of Education, the University of the State of New York, and ROBERT ABRAMS, Ind., and as Attorney General,

Defendants-Appellants.

Appeal from the United States District Court
from the Northern District of New York

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of New York and was argued by counsel.

ISSUED AS MANDATE: May 7, 1991

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Nos. 595, 690—August Term, 1990

(Argued: November 26, 1990 Decided: March 12, 1991)

Docket Nos. 90-7269, -7309

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff-Appellee,
Cross-Appellant,

—v.—

MARIO CUOMO, Ind., and as Governor of the State of New York; THEODORE M. BLACK, Ind., and as Chancellor, Board of Regents of the University of the State of New York; WILLARD A. GENRICH, Ind., and as Vice Chancellor, Board of Regents of the University of the State of New York; KENNETH B. CLARK, HAROLD E. NEWCOMB, EMLYN I. GRIFFITH, MARY ALICE KENDALL, JORGE L. BATISTA, LOUIS E. YAVNER, LAURA BRADLEY CHODOS, MARTIN C. BARELL, JOSEPH R. BONGIORNO, LOUISE P. MATTEONI, J. EDWARD MEYER, ARLENE B. REED-DELANEY, R. CARLOS CARBALLADA, Ind., and as Members of the Board of Regents of the University of the State of New York, GORDON M. AMBACH, Ind., and as Commissioner of Education, the University of the State of New York, and ROBERT ABRAMS, Ind., and as Attorney General,

Defendants-Appellants,
Cross-Appellees.

Before:

ALTIMARI and MAHONEY, *Circuit Judges*,
and DALY, *District Judge.**

Appeal from judgment, entered in the United States District Court for the Northern District of New York (Neil P. McCurn, *C.J.*), granting plaintiff's motion for summary judgment and permanently enjoining defendants from enforcing various provisions of the New York Standardized Testing Act, N.Y. Educ. L. § 340 *et seq.* (McKinney 1988).

Reversed, vacated and remanded.

Judge Mahoney concurs in part and dissents in part in a separate opinion.

ROBERT A. BURGOYNE, Washington, D.C. (Carl W. Vogt, Fulbright & Jaworski, Washington, D.C.; Joseph A. Keyes, Jr., Association of American Medical Colleges, Washington, D.C.; Carroll J. Mealey, Christopher Massaroni, DeGraff, Foy, Conway, Holt-Harris & Mealey, Albany, N.Y., of counsel), *for Plaintiff-Appellee, Cross-Appellant.*

DANIEL SMIRLOCK, Assistant Attorney General, Albany, N.Y. (Robert Abrams, Attorney General of the State of New York, O. Peter Sherwood, Solicitor General, Peter H. Schiff, Deputy Solicitor General, Albany, N.Y., of counsel), *for Defendants-Appellants, Cross-Appellees.*

BRUCE P. KELLER, New York, N.Y. (Lorin L. Reisner, Debevoise & Plimpton, New York, N.Y.; Alan B. Morrison, David C. Vladeck, Public Citizen Litigation Group, Washington, D.C., of counsel), *for amici curiae National*

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* The Honorable T.F. Gilroy Daly, District Judge of the United States District Court for the District of Connecticut, sitting by designation.

Center for Fair & Open Testing, Public Citizen Litigation Group, The Center for Women Policy Studies, Arthur O. Eve, The Fund for the Feminist Majority, Golden Rule Insurance Company, Mexican American Legal Defense and Educational Fund, National Education Association, The National Women's Law Center, New York Public Interest Research Group, and NOW Legal Defense and Education Fund.

DAVID M. WHITE, Berkley, C.A., *for amici curiae Testing for the Public, Puerto Rican Legal Defense and Education Fund, United States Students Association, and The Equality in Testing Project.*

EDWARD W. KEANE, New York, N.Y. (Henry Christensen III, David G. Feher, Sullivan & Cromwell, New York, N.Y., of counsel), *for amicus curiae College Entrance Examination Board.*

ALTIMARI, Circuit Judge:

The central question presented by this appeal is whether the district court erred in holding that the disclosure requirements of New York's Standardized Testing Act, N.Y. Educ. L. § 340 *et seq.* (McKinney 1988) ("STA"), are pre-empted by the federal Copyright Act of 1976, 17 U.S.C. § 101 *et seq.* (1988) ("Copyright Act"). Defendants-appellants, cross-appellees Mario Cuomo *et al.* (the "State") appeal from a judgment, entered in the United States District Court for the Northern District of New York (Neil P. McCurn, *Chief Judge*), granting plaintiff-appellee, cross-appellant American Association of Medical Colleges" ("AAMC") motion for summary judgment and enjoining the State from enforcing various provisions of the STA against AAMC. *Association of American Medical Colleges v. Carey*, 728 F. Supp. 873 (N.D.N.Y. 1990) ("*AAMC II*").

In 1979, AAMC initiated this action for declaratory and injunctive relief, alleging that the STA operates to infringe its federal copyright in the test forms, questions, answers, and reports prepared in connection with the administration of the Medical College Admission Test ("MCAT"). It further alleged that, as a result of the conflict between the STA and the Copyright Act, the former was preempted pursuant to the Constitution's Supremacy Clause, U.S. Const., art. VI, cl. 2. The State responded that the STA's treatment of the MCAT constitutes a "fair use" under the Copyright Act, 17 U.S.C. § 107 (1988), and, therefore, that the STA was not preempted.

On October 25, 1988, after nearly ten years of litigation, AAMC moved for summary judgment on its complaint. The State opposed this motion and cross-moved for dismissal of AAMC's pendent claims based on the New York State Constitution. On January 12, 1990, the district court granted AAMC's motion for summary judgment and enjoined enforcement of certain STA provisions which it found to conflict with the Copyright Act. The court also granted the State's motion to dismiss AAMC's pendent state constitutional claims and denied AAMC's request for attorney's fees.

On appeal, the State contends that the district court erred in granting summary judgment in favor of AAMC. It argues that genuine issues of material fact exist, particularly with regard to the effect of the STA's disclosure provisions on the copyrighted material's market value. The State also contends that the scope of the court's injunction is overly broad, even if the Copyright Act is deemed to preempt some STA provisions. AAMC, in its cross-appeal, argues that the court improperly denied its request for attorney's fees under section 505 of the Copyright Act. For the reasons set forth below, we reverse the judgment of the district court, vacate the permanent injunction, and remand for further proceedings.

BACKGROUND

AAMC is a non-profit educational association comprised of medical schools, teaching hospitals, and academic societies. It sponsors a testing program for medical school applicants which is designed to provide medical school admissions committees with a uniform standard for measuring aptitude. The central feature of this program is the MCAT, a test developed at AAMC's request by the American Institutes for Research in the Behavioral Sciences ("AIR"). The exam consists of some 300 questions and is designed to measure a test-taker's knowledge of chemistry, biology, and physics, as well as his or her reading and quantitative skills. Virtually every medical school in the United States requires applicants to take the MCAT.

The AAMC holds copyrights in MCAT test forms, test questions, answer sheets, and reports. It has never made the MCAT or test answers available to the general public. AAMC does, however, make one "practice test"—a previously-used test that was compromised through unauthorized disclosure—available to interested applicants. After the exams are graded, AAMC sends examinees only their MCAT scores and does not permit them access to test questions or answer keys.

In 1979, the State of New York enacted the STA in order to open the standardized testing process to public scrutiny. In its present form, the STA provides that "[w]henever any test agency prepares or causes to have prepared research which is used in any study, evaluation or statistical report pertaining to a test . . . , such study, evaluation or report shall be filed with" the Commissioner of Education. N.Y. Educ. L. § 341. Test agencies also must prepare and file reports analyzing test scores according to race, ethnicity, gender and linguistic background for tests given between July 1, 1988 and July 1, 1989. N.Y. Educ. L. § 341-a. In addition, "[w]ithin thirty days after the results of any standardized test are re-

leased," a test agency must file "a copy of all test questions used in calculating the test subject's raw score" and "the corresponding acceptable answers to those questions" with the Commissioner of Education. N.Y. Educ. L. §§ 341, 342(7), subjecting them to public inspection upon request under the New York Freedom of Information Law, N.Y. Pub. Off. L. § 84 *et seq.* (McKinney 1988). Finally, the STA requires that, after the test has been filed with the Commissioner, the test agency must "provide to the test subject the opportunity to secure" test questions and answers, and "may charge a nominal fee for providing such information." N.Y. Educ. L. § 342(2).

Following enactment of the STA, AAMC commenced an action for declaratory and injunctive relief, alleging that the STA facilities infringement of its copyrights in MCAT forms, questions, answers, and reports. AAMC contended that, as a result, the STA is preempted by the federal Copyright Act, 17 U.S.C. § 101 *et seq.* In January 1980, finding AAMC to have satisfied the prerequisites to obtain preliminary injunctive relief, the district court granted AAMC's motion for a preliminary injunction against enforcement of sections 341 and 342 of the STA. *Association of American Medical Colleges v. Carey*, 482 F. Supp. 1358 (N.D.N.Y. 1980) ("*AAMC I*"). Following a lengthy period of discovery, AAMC amended its complaint to allege, *inter alia*, that sections 341, 341-a, and 342 of the STA are preempted by the federal Copyright Act. In addition, AAMC alleged that the STA's provisions infringed its copyright, in violation of 17 U.S.C. § 501(a) (1988), and constituted a seizure of its exclusive rights, in violation of 17 U.S.C. § 201(e) (1988). AAMC also alleged that the STA violated several provisions of the New York and federal constitutions.

AAMC moved for summary judgment in October 1988. The State opposed the motion and cross-moved for dismissal of AAMC's pendent state constitutional claims. On January 12, 1990, the district court granted AAMC's mo-

tion for summary judgment and the State's motion to dismiss the pendent claims. *AAMC II*, 728 F. Supp. at 889. The court found that the STA's requirement that AAMC disclose its test materials conflicts with the copyright protection due those materials under the federal Copyright Act. It further found that this disclosure does not constitute a "fair use" of the MCAT under the Copyright Act. Accordingly, it concluded that the STA is preempted by the Copyright Act and permanently enjoined the State from enforcing the STA against AAMC. The court denied AAMC's request for attorney's fees and costs. This appeal and cross-appeal followed.

DISCUSSION

I. *Defining the issue.*

As the district court stated, "[t]he central legal question presented is whether the disclosure requirements of New York's Standardized Testing Act clash with rights conferred upon plaintiff by the Federal Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*, in a manner which compels this court to find the State Act invalid by virtue of the Supremacy Clause of the U.S. Constitution." *AAMC II*, 728 F. Supp. at 874. The Constitution's Supremacy Clause may compel invalidation of state law in several ways:

> First, Congress may in express terms declare its intention to preclude state regulation in a given area. . . . Second, in the absence of an express declaration, preemption may be implied when the federal law is "sufficiently comprehensive to make reasonable the inference that Congress 'left no room' for supplementing state regulation." . . . Finally, state law may be preempted "to the extent that it actually conflicts with a valid federal statute."

Darling v. Mobil Oil Corp., 864 F.2d 981, 985-86 (2d Cir. 1989) (citations omitted). The third type of state law preemption enumerated in *Darling*, so-called "conflict

preemption," occurs either when " 'compliance with both federal and state regulations is a physical impossibility,' . . . or where state law 'stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.' " *Id.* at 986 (citations omitted); *see Perez v. Campbell*, 402 U.S. 637, 649 (1971).

AAMC contends that the STA conflicts with its exclusive right to publish, copy and distribute MCAT materials, *see* 17 U.S.C. § 106 (1988), by requiring disclosure of those materials to test-takers and by facilitating public distribution of those materials. According to AAMC, this conflict between state law and federally-created rights renders the state law preempted. *See Goldstein v. California*, 412 U.S. 546, 559 (1973); *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408, 441-42 (S.D. Ohio 1980), *aff'd in pertinent part*, 679 F.2d 656 (6th Cir. 1982).

In response, the defendants argue that the disclosure envisioned by the STA does not infringe upon the copyrights held by AAMC. They argue that the STA merely facilitates "fair uses" of the copyrighted material and, therefore, is consistent with the federal Copyright Act, which contains a 'fair use" defense to copyright infringement. *See* 17 U.S.C. § 107; *see also Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984) ("[A]nyone who trespasses into [the copyright owner's] exclusive domain by using or authorizing the use of the copyrighted work . . . "is an infringer of the copyright." [17 U.S.C.] § 501(a). Conversely, anyone who is authorized by the copyright owner to use the copyrighted work . . . or who makes a fair use of the work is not an infringer of the copyright . . . .").

"Our task is 'to determine whether, under the circumstances of this particular case, [the State's] law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.' " *Jones v.*

Rath Packing Co., 430 U.S. 519, 526 (1977) (citation omitted). Thus, we must determine whether the disclosure of the MCAT facilitated by the STA infringes on the copyrights held by AAMC. If the STA facilitates infringement, it conflicts with the federal Copyright Act and is preempted. Such a determination is made in light of the "fair use" defense since "[t]he existence of a hypothetical or potential conflict is insufficient to warrant the pre-emption of the state statute." *Rice v. Norman Williams Co.*, 458 U.S. 654, 659 (1982).

II. *The fair use doctrine.*

It has long been recognized that certain unauthorized but "fair" uses of copyrighted material do not constitute copyright infringement. *See Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 549 (1985) (defining fair use as "privilege . . . to use the copyrighted material in a reasonable manner without [the copyright owner's] consent") (quoting H. Ball, *Law of Copyright and Literary Property* 260 (1944)); 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.05, at 13-79 (1990) ("*Nimmer on Copyright*"). This "fair use" doctrine "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Iowa State Univ. Research Foundation, Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (2d Cir. 1980).

The fair use defense was expressly recognized in the Copyright Act of 1976, which codified factors relevant to determining the applicability of the doctrine. *See Nimmer on Copyright* § 13.05 [A], at 13-82 to 13-83. Section 107 of the Copyright Act, in pertinent part, provides:

> Notwithstanding the provisions of section 106, the fair use of a copyrighted work . . . for purposes such as criticism, comment, . . . scholarship, or research, is not an infringement of copyright. In determining

> whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107. "The factors enumerated in [section 107] are not meant to be exclusive: '[S]ince the doctrine [of fair use] is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.'" *Harper & Row*, 471 U.S. at 560 (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. 65, *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5679). "Fair use is a mixed question of law and fact." *Id.* at 560. Evaluation of the statutory fair use factors "in a particular case is obviously a fact specific inquiry for which summary judgment is ill-suited." *Diamond v. Am-Law Publishing Corp.*, 745 F.2d 142, 147 (2d Cir. 1984); *accord DC Comics, Inc. v. Reel Fantasy, Inc.*, 696 F.2d 24, 28 (2d Cir. 1982); *Meeropol v. Nizer*, 560 F.2d 1061, 1070-71 2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

In the present case, the district court appraised the statutory fair use factors in the following manner. Initially, it held that "the purpose and character of the use[s]" envisioned by the STA serve important public interests. *AAMC II*, 728 F. Supp. at 884-885. As the State explains, the STA is "intended to serve the public interest in the validity and objectivity of tests, to en-

courage development of better test instruments, and to assure the accuracy of the scoring process." The State does not seek to exploit disclosed MCAT materials commercially, *cf. Association of American Medical Colleges v. Mikaelian*, 571 F. Supp. 144, 151-53 (E.D. Pa. 1983), *aff'd without opinion*, 734 F.2d 3 (3d Cir. 1984), but rather to foster the "criticism, comment, . . . scholarship, [and] research" contemplated by section 107. *See Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1260 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987). Thus, the court concluded that the first "fair use" factor favors the position asserted by the State. *See Sony Corp. of America*, 464 U.S. at 449. This conclusion is essentially uncontested by the parties, and we find no reason to disturb it.

Next, the district court held that "the second [fair use] factor cuts in favor of" AAMC, since the MCAT is an unpublished work. *AAMC II*, 728 F. Supp. at 885-86. *See New Era Publications Int'l v. Henry Holt and Co.*, 873 F.2d 576, 583 (2d Cir. 1989), *cert. denied*, 110 S. Ct. 1168 (1990); *Salinger v. Random House, Inc.*, 811 F.2d 90, 97 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987). On appeal, the State reiterates its contention that the MCAT does not fall within the traditional published/unpublished dichotomy because of the limited exposure to the test regularly granted to test-takers. However, we are inclined to agree with the district court that the secure nature of the MCAT weighs in favor of AAMC. *See Naional Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 486 n.8 (7th Cir. 1982) (in upholding validity of Copyright Office's secure test deposit regulation, court noted: "We agree with the Register of Copyrights that the [Multistate Bar Exam] would probably be classified as an unpublished work under 17 U.S.C. § 101 . . . ."), *cert. denied*, 464 U.S. 814 (1983); *Association of American Medical Colleges v. Mikaelian*, 571 F. Supp. at 153. Moreover, we recognize

that the MCAT is not a mere compilation of facts; it is a "creative, imaginative, and original" work, *MCA, Inc. v. Wilson*, 677 F.2d 180, 182 (2d Cir. 1981) (citation omitted), and reflects a substantial investment aimed at accurately discerning the aptitude of medical school applicants, *Association of American Medical Colleges v. Mikaelian*, 571 F. Supp. at 150.

Furthermore, the district court held that the third fair use factor, *i.e.*, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole," *Harper & Row*, 471 U.S. at 564, favored AAMC's position. *AAMC II*, 728 F. Supp. at 886-87. The State does not seriously contest this conclusion since the STA would permit comprehensive disclosure and distribution of the MCAT and related materials. Although the STA would not require disclosure of ungraded questions used solely for field-testing purposes, the amount and substantiality of disclosure desired by the State is obviously extensive. Thus, we are inclined to agree with the court's evaluation of the third fair use factor.

Finally, the district court considered the fourth fair use factor, *i.e.*, the "effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107(4). The fourth fair use factor is considered "the single most important element of fair use." *Harper & Row*, 471 U.S. at 566. It requires appraisal of whether "some meaningful likelihood of future harm [to the market for or value of the copyrighted work] exists. If the intended use is for commercial gain, that likelihood may be presumed. But if it is for a noncommercial purpose, the likelihood must be demonstrated." *Sony Corp. of America*, 464 U.S. at 451; *see Salinger v. Random House*, 811 F.2d at 99; *Nimmer on Copyright* § 13.05[A], at 13-88.12. Adverse impact that results from criticism or unfavorable comment on the copyrighted work is not considered in evaluating this factor. *See New Era Publications Int'l v. Carol Publishing Group*, 904 F.2d 152,

160 (2d Cir. 1990) ("*New Era II*"); *Consumers Union of United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1051 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984).

Applying these standards, the court held that "disclosure of the MCAT test questions would prevent them from being reused by the plaintiff." *AAMC II*, 728 F. Supp. at 888. Accordingly, it concluded that the disclosure and distribution contemplated by the STA "would seriously impair or even destroy the value of the copyrighted exams." *Id.* The State challenges this conclusion, and asserts that expert testimony to the contrary created genuine issues of material fact that precluded summary judgment. We agree.

In opposition to AAMC's claim that disclosure would negatively affect the value of the MCAT, the State presented the testimony of Professor Walter M. Haney, Director of the Educational Technology Program at Boston College. Professor Haney testified that it was "entirely conceivable" that disclosed MCAT questions would be reusable. In a later affidavit, Professor Haney referred to a study concerning the effects of disclosure on performance on the Test of English as a Foreign Language ("TOEFL") which stated: "[a]s more and more disclosed TOEFL tests become available . . . the effect of test disclosure should diminish to a negligible level, eventually allowing disclosed TOEFL items to be reused in institutional test forms." Professor Haney also testified that various equating strategies might be employed to reduce any scoring deviations resulting from re-use of MCAT questions. This testimony consisted of highly technical evaluations of alternative equating strategies, including embedded anchor test equating, item response theory equating, and section pre-equating. The district court dismissed this testimony as "irresolute" and "equivocal." *Id.* at 887, 888. While the trier of fact may ultimately reach this same conclusion, summary

judgment is not the appropriate moment for resolving issues of witness credibility. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

Moreover, we reject the district court's conclusion that a copyright owner, such as AAMC, should not be "required to change its operations when another individual or entity is interfering with its ownership rights under the Federal Copyright Act in order to make the fair use exception fit." *AAMC II*, 728 F. Supp. at 888. Fair use is an "equitable rule of reason," *Harper & Row*, 471 U.S. at 560 (quotation omitted), which is not amenable to such mechanical application. Generally, a copyright owner should not be expected to take steps to minimize the potential harm that a particular unauthorized use might cause to the copyrighted material's value. However, given the laudable goals of the State in enacting the STA, this is a case in which some accommodation by the copyright owner may be legitimately expected. *See MCA, Inc. v. Wilson*, 677 F.2d at 183 ("[W]here a claim of fair use is made, a balance must sometimes be struck between the benefit the public will derive if the use is permitted and the personal gain the copyright owner will receive if the use is denied.").

This case does not present the relatively straightforward situation in which the potential harm to a copyrighted work flows from direct competition with the assertedly fair use. In such circumstances, we have noted our concern that "creation will be discouraged if demand can be undercut by copiers." *Consumers Union*, 724 F.2d at 1051 (quoted in *New Era II*, 904 F.2d at 160). In the present case, however, the purported harm to the MCAT stems from a non-commercial, non-competing use. Moreover, the degree of potential harm to the MCAT and the availability of means to minimize that harm are sharply in dispute. Accordingly, there remain factual issues which deserve further elucidation before the district court.

CONCLUSION

In light of the foregoing, we reverse the judgment of the district court, vacate the permanent injunction, and remand for further proceedings. The State shall be enjoined from enforcing the STA provisions against AAMC during the pendency of the remand proceedings.

Given our decision to remand this case to the district court, it would be inappropriate to address the State's contentions regarding the breadth of the court's injunction or AAMC's cross-appeal from the denial of attorney's fees. Accordingly, we express no view on those issues at this time.

MAHONEY, Circuit Judge, concurring in part and dissenting in part:

Addressing the issue as framed by the parties on appeal, I generally agree with my colleagues' conclusion that summary judgment was improper because there existed genuine issues of material fact regarding New York State's fair use defense. Because it is challenging noncommercial use by the state, AAMC has the burden of proving "that *some* meaningful likelihood of future harm [to marketability] exists." *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 451 (1984). I agree that Professor Haney's testimony was sufficient to create a factual issue in this regard, and that the availability of means to minimize any such harm is also in dispute. Further, at least two requirements of the STA--filing any research reports used in preparing the MCAT, and filing statistical reports that categorize scores by race and gender with a committee that reports to the state legislature—appear unrelated to the district court's concern with the AAMC's ability to reuse questions.

I write separately to express my doubt concerning a more fundamental aspect of the district court's opinion, the recognition of a preemption-type conflict between the STA and the Copyright Act. The district court reasoned as follows on this issue:

> [T]he New York statute will require the AAMC as owner of a copyrighted standardized test to disclose an exam which it wishes to retain as confidential. The State Act will also make the disclosed MCAT materials "public records" with respect to New York's Freedom of Information Law, and therefore subject these documents to reproduction and disclosure to members of the public. As such, unless the disclosure provisions of the New York statute fall into an exception to the exclusive rights of a copyright owner, those provisions will directly conflict with federal law and thereby be preempted.

Association of Am. Medical Colleges v. Carey, 728 F. Supp. 873, 881 (N.D.N.Y. 1990). My colleagues, apparently in substantial agreement with this analysis, conclude: "If the STA facilitates infringement, it conflicts with the federal Copyright Act and is preempted" (subject, of course, to defenses, such as fair use, provided by the Copyright Act itself).

I would not find a fatal conflict so easily. There is a meaningful distinction between AAMC's exclusive right to reproduce and distribute its copyrighted MCAT and the business of administering, and evaluating students' responses to, the MCAT as a means of ranking medical school applicants. The former is protected by the copyright laws, and New York cannot create its own scheme whereby an author establishes and protects the reproduction and distribution of his work. But when the AAMC seeks to administer the MCAT and rank applicants on the results, it enters a field of conduct that, as I view the matter, New York may permissibly regulate. Specifically, it seems to me that New York may require that the author of such an examination surrender a limited amount of his copyright protection in exchange for the privilege of administering the examination within the state.

The district court addressed this matter briefly:

> Defendants . . . contend that the State Act does not force [AAMC] to disclose the MCAT materials, but rather presents the AAMC with a choice: avoid disclosure by not administering the exam within New York or administer the MCAT within New York and be subject to the State's disclosure requirements. This argument, while of potential use in situations where the State is seeking to regulate an area left open by the federal government, has no merit where the State law is preempted by the federal law pursuant to the Supremacy Clause. A state may not answer an assertion of federal rights with

> the reply that one should go elsewhere to exercise those rights. *Cf. Capital Cities Cable v. Crisp*, 467 U.S. at 711, 104 S. Ct. at 2706.

728 S. Supp. at 888. There is, however, no federal regulation of standardized testing that would displace New York's statutory scheme. *Capital Cities*, by contrast, involved cable television, an area of pervasive federal regulation.

I would rule that a limited degree of interference with copyright privileges is permissible where a state, for purposes wholly unrelated to the policies that underly the protection of intellectual property, endeavors to regulate the manner in which an author markets his expression. Here, the chosen means of marketing the MCAT results in a secretive method of ranking medical school applicants. The State's policy is directed at that marketing strategy, and any interference with copyrights is incidental.

An analogy can be found in state statutes that regulate the licensing arrangements between movie distributors and theatre operators. In *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408 (S.D. Ohio 1980), *aff'd in pertinent part and remanded in part*, 679 F.2d 656 (6th Cir. 1982), Ohio had enacted a statute that, *inter alia*: (1) required distributors to provide potential exhibitors with a "trade screening" of a film prior to the commencement of bidding or negotiation for a license, and (2) prohibited distributors from exacting a minimum guaranteed payment in connection with any licensing agreement that based payments upon a division of box office receipts. 496 F. Supp. at 419-20. The distributors contended that the statute conflicted with the copyright protection of their films, and was accordingly preempted.

The district court rejected the preemption challenge, pointing out that "[t]he Supreme Court has long recog-

nized the distinction between the rights composing copyright and the property produced and marketed by virtue of the copyright." *Id.* at 446. Reviewing cases that upheld the taxation and antitrust regulation of copyrighted materials, *id.* at 446-47, the court concluded that "[t]he authority of the states to regulate market practices dealing with copyrighted subject matter is well-established." *Id.* at 447.

With respect to the requirement of a trade screening, the distributors argued that the state statute unlawfully compelled a performance, an exclusive right under the Copyright Act. In rejecting this position, the *Allied Artists* court engaged in the same analysis that the defendants herein urged upon the district court below:

> [T]he trade screening requirement only affects copyright holders who wish to license their films in Ohio; it does not compel performance in any other circumstances.
>
> The provision does not deprive the plaintiffs of their right to decide whether or not to perform the work. . . . [T]he plaintiffs are free to choose not to perform their work publicly, and may continue to enjoin others from performing it. Thus they retain complete control over the rights granted by the Copyright Act: to prohibit display, performance, reproduction and distribution. It is only *after* the copyright owner has made the decision to perform the work—to release the motion picture—in Ohio that the Ohio Act steps in and compels a performance before exhibitors as a condition to the distribution of films in Ohio.

496 F. Supp. at 447.

On appeal, the Sixth Circuit expressly adopted the analysis of the Ohio district court with respect to the distributors' copyright preemption challenge. *See* 679

F.2d at 662-63 & n.4. Further, in addressing a similar Pennsylvania statute against which the same copyright preemption argument was advanced, the Third Circuit "agree[d] with the framework of analysis set forth by the Ohio district court and adopted by the Sixth Circuit [in *Allied Artists*]." *Associated Film Distribution Corp. v. Thornburgh*, 683 F.2d 808, 816-17 (3d Cir. 1982); *see also Associated Film Distribution Corp. v. Thornburgh*, 614 F. Supp. 1100, 1121-24 (D. Pa. 1985) (following *Allied Artists* and finding no preemption), *aff'd*, 800 F.2d 369 (3d Cir. 1986), *cert. denied*, 480 U.S. 933 (1987); *Warner Bros., Inc. v. Wilkinson*, 533 F. Supp. 105, 108 (D. Utah 1981) (similar ruling), *appeal dismissed and case remanded*, 782 F.2d 136 (10th Cir. 1985).

In sum, I cannot agree that a preemptive conflict between the Copyright Act and the STA results if the STA is deemed to "facilitate" copyright infringement, subject only to the defenses accorded by the Copyright Act. Rather, I would direct the district court to address the threshold preemption question on remand in accordance with the principles and authorities set forth hereinabove.

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 595 August Term, 1990

(Submitted: September 11, 1990 Decided: Sep. 14, 1990)

Docket No. 90-7269

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff-Appellee,
Cross-Appellant,

v.

MARIO CUOMO, Individually, and as Governor of the State of New York, Theodore M. Black, Individually, and as Chancellor, Board of Regents of the University of the State of New York, WILLARD A. GENRICH, Individually and as Vice Chancellor, Board of Regents of the University of the State of New York, KENNETH B. CLARK, HAROLD E. NEWCOMB, EMLYN I. GRIFFITH, MARY ALICE KENDALL, JORGE L. BATISTA, LOUIS E. YAVNER, LAURA BRADLEY CHODOS, MARTIN C. BARELL, JOSEPH R. BONGIORNO, LOUISE P. MATTEONI, J. EDWARD MEYER, ARLENE B. REED-DELANEY, R. CARLOS CARBALLADA, Individually, and as Members of the Board of Regents of the University of the State of New York, GORDON M. AMBACH, Individually, and as Commissioner of Education, the University of the State of New York, and ROBERT ABRAMS, Individually, and as Attorney General,

Defendants-Appellants,
Cross-Appellees.

Before: LUMBARD, WINTER and MINER, *Circuit Judges.*

Motion to dismiss an appeal from a judgment of the United States District Court for the Northern District of New York (Neal P. McCurn, *Chief Judge*), for failure to comply with the notice provision of Fed. R. App. P. 3(c). We deny the motion because the phrase "the defendants in the above matter hereby appeal" sufficiently specifies that all of the defendants are appealing.

Robert A. Burgoyne, Washington, D.C. (Carl W. Vogt, Fulbright & Jaworski, Washington, D.C., of counsel), *for Cross-Appellant.*

Daniel Smirlock, Assistant Attorney General, Albany, New York (Robert Abrams, Attorney General of the State of New York, O. Peter Sherwood, Soliciltor General, Peter H. Schiff, Deputy Solicitor General, Albany, New York, of counsel), *for Cross-Appellees.*

PER CURIAM:

Cross-appellees, eighteen New York State officials, appeal from a grant of summary judgment in favor of cross-appellant Association of American Medical Colleges ("AAMC"). Cross-appellees filed a timely notice of appeal stating

> PLEASE TAKE NOTICE that the defendants in the above matter hereby appeal to the United States Court of Appeals for the Second Circuit, from the final order of judgment entered by the Court on February 13, 1990.

AAMC moves for an order dismissing the appeal for lack of jurisdiction on the ground that the notice of appeal failed to comply with the specificity requirements of Federal Rule of Appellate Procedure 3(c) because it did not list the appealing parties individually. We deny the motion.

Rule 3(c) requires in relevant part that "[t]he notice of appeal shall specify the party or parties taking the appeal." Although failure to name a party in a notice of appeal constitutes a failure of that party to appeal, *see Torres v. Oakland Scavenger Co.*, 487 U.S. 312, 314 (1988), such defect may be immaterial if the notice of appeal contains the "functional equivalent" of a listing of each appealing party's name, *see id.* at 317. We hold that the phrase "the defendants in the above matter hereby appeal" was the functional equivalent of naming each and every defendant in this action. *See Baylis v. Marriott Corp.*, 906 F.2d 874 (2d Cir. 1990) (holding that "the specification that the appeal was taken by 'all of the plaintiffs in this action' was the functional equivalent of a plaintiff-by-plaintiff listing"). The notice of appeal was thus sufficiently precise to fulfill the specificity requirement of Rule 3(c).

Motion denied.

APPENDIX D

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

79-CV-730

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff,

-v-

HUGH L. CAREY, Individually and as Governor, et al.,
Defendants.

OF COUNSEL:

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MEMORANDUM-DECISION AND ORDER

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I. Introduction

The plaintiff is moving for summary judgment on its claims that portions of New York's Standardized Testing Act, N.Y. Educ. Law §§ 340-348, (generally known as the "Truth-in-Testing" Act), are (1) invalid due to pre-

emption by federal copyright law and regulations, (2) infringe upon plaintiff's ownership rights under federal copyright law, or (3) violate the United States Constitution. Plaintiff, the Association of American Medical Colleges (the "AAMC"), seeks a declaratory judgment as well as a permanent injunction barring enforcement of what has been termed the "disclosure provisions" of the State Act. The AAMC is the copyright owner of the Medical College Admission Test (the "MCAT") as well as a number of MCAT related studies. The disclosure provisions, N.L. Educ. Law §§ 341, 341-a, and 342, generally require the plaintiff to disclose MCAT test questions, answers, answer sheets, and related research reports which are employed by plaintiff as part of its sponsorship of the MCAT. In short, the plaintiff seeks to use federal copyright laws as a shield against enforcement of the State Act—thereby keeping the MCAT test questions secret. The central legal question presented is whether the disclosure requirements of New York's Standardized Testing Act clash with rights conferred upon plaintiff by the Federal Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*, in a manner which compels this court to find the State Act invalid by virtue of the Supremacy Clause of the U.S. Constitution.

This matter has now been pending for almost a decade. Upon the plaintiff's Rule 65 application, this court, on January 21, 1980, preliminarily enjoined the enforcement of N.Y. Educ. Law §§ 341 and 342 as against the plaintiff until resolution of this action. *Association of American Medical Colleges v. Carey*, 482 F.Supp. 1358, 1364 (N.D.N.Y. 1980). The Standardized Testing Act has subsequently been amended, incorporating additional disclosure requirements which have also been challenged by the AAMC.

II. Issue

The amended complaint asserts twelve separate causes of action against the Governor of the State of New York, the State Attorney General, the Board of Regents of the

University of the State of New York, and New York's Commissioner of Education. The defendants have been found to be proper parties due to their enforcement responsibilities with respect to the education law. *See Association of American Medical Colleges v. Carey*, 482 F.Supp. at 1362-64.

The first five counts assert that the disclosure provisions are invalid because they encroach upon ownership rights granted to plaintiff by the Federal Copyright Act of 1976. *Count I* asserts that the challenged portions of the New York Standardized Testing Act conflict with the exclusive ownership rights granted to the plaintiff under the Federal Copyright Act, 17 U.S.C. § 106(1), (3), and (5), and are thereby preempted under the Supremacy Clause of the U.S. Constitution. Plaintiff also claims that the New York Act is preempted due to a conflict with validly promulgated federal copyright regulations. *Count II* alleges that defendants, by acting in accordance with the disclosure provisions of the New York Act, will compel the plaintiff to reproduce and distribute copyrighted MCAT test forms and studies, thereby aiding in the unauthorized distribution of these documents. By so doing, the defendants allegedly will be interfering in federal rights conferred by the Copyright Act—statutory activity which plaintiff believes is expressly preemtped by section 301 of the Copyright Act, 17 U.S.C. § 301(a). *Count III* alleges that the disputed provisions of the New York Act will require the plaintiff to disclose MCAT materials. This forced disclosure will allegedly constitute an infringement upon plaintiff's ownership rights in copyrighted material in violation of 17 U.S.C. § 501(a). *Count IV* asserts that the disclosure provisions of the New York Act will cause the defendants to engage in vicarious and contributory infringement upon plaintiff's ownership rights. *Count V* asserts that the New York Act will cause the defendants, as part of a governmental entity, to seize and expropriate the

plaintiff's ownership rights, a violation of 17 U.S.C. § 201(e).

The remaining allegations of the complaint assert claims for relief under provisions of the Federal and State Constitutions. The parties, however, have focused their argument here on the merits of the copyright claims, agreeing that this court must attempt to resolve the statutory issues before reaching the constitutional causes of action. *See Hagans v. Lavine*, 415 U.S. 528, 543 (1974). Defendants assert and plaintiff admits, see Plaintiff's Reply Memorandum of Law at 2, that the claims based on the New York State Constitution are not properly before this court. Therefore, Counts VII, VIII, X, and XII are dismissed.

III. Legal Background

A. The Standardized Testing Act

The Standardized Testing Act imposes a number of obligations on organizations which develop or sponsor "any test that is given in New York at the expense of the test subject and [which is] designed for use and is used in the process of selection for post-secondary or professional school admissions." N.Y. Educ. Law § 340(1). The Act specifically includes within its provisions the Medical College Admission Test. *Id.* It is undisputed that the AAMC is a "test agency" as that term is defined by § 340(4) of the Act and therefore properly subject to its dictates.[1] In this action plaintiff is challenging the disclosure provisions of the Truth in Testing Act, namely sections 341, 341-a, and 342.

Section 341 (entitled "Background reports") requires that "[w]henever any test agency prepares or causes to have prepared research which is used in any study, evaluation or statistical report pertaining to a test operational

[1] The AAMC has contracted with the American Institutes for Research in the Behavorial Sciences to develop and test MCAT questions. The exam is actually administered, again through contract, by the American College Testing Program.

after January first, nineteen hundred eighty, such study, evaluation or report shall be filed" with the New York State Commissioner of Education ("the Commissioner"). *Id.* at § 341(1). These reports must have all information with respect to a test subject or user institution redacted from the document. *Id.* at § 341(2). All testing agencies, within thirty days after the results of a standardized test are released, must also file with the Commissioner (1) a copy of all test questions *actually used* in calculating a test taker's raw score (experimental or developmental questions are excluded from disclosure), (2) the correct answers to these questions, and (3) the rules governing the method by which a raw score is calculated along with an explanation of these rules. *Id.* at § 342(1).

Within ninety days after the filing required by § 342(1), the test agency must provide a test taker with the "opportunity to secure" (1) a copy of the test questions used to calculate the test subject's raw score, (2) a copy of the test subject's answer sheet along with a copy of the correct answers, and (3) the test subject's raw score. *Id.* at § 342(2). Due to a concern that standardized tests may be biased in some manner, section 341-a was added to the Standardized Testing Act in 1987. This provision requires the testing agency to prepare detailed statistical reports—categorized by race, ethnicity, gender and linguistic background—relating to performance on tests and test questions given between July 1, 1988, and July 1, 1989. *Id.* at §§ 341-a(4), 341-a(5). These reports are to be filed with a ten-person advisory committee to the state legislature not later than September 1, 1989. The advisory committee, in turn, is required to report to the legislature. *Id.* at §§ 341-a(5), 346-a. "Any test agency which violates any section of [the Act] shall be liable for a civil penalty of not more than five hundred dollars for each violation." *Id.* at § 347. It should be noted that the Standardized Testing Act only applies to exams administered within New York. *Id.* at § 340(1).

The disclosure provisions of the Act designate all documents filed with the Commisssioner of Education or with the legislative advisory committee as "public records." The parties do not dispute that the New York Freedom of Information Law ("FOIL"), N.Y. Pub. Off. Law § 84 *et seq.*, provides that all documents designated as "public records" must be made available to the public for inspection upon request. *Id.* at § 87(2). Therefore, as plaintiff points out, the Truth in Testing Act, if applied, would make MCAT test questions available to the Commissioner of Education, the examinees, the legislative advisory committee, and the general public. It would also make these materials available for review by organizations engaged in the business of coaching students for the MCAT.

B. The Copyright Act of 1976

Congress, through the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*, set out to "accomplish a fundamental and significant change" in the law of copyright.[2] "Instead of a dual system of 'common law copyright' for unpublished works and statutory copyright for published works, which ha[d] been the system in effect in the United States since the first copyright statute in 1790, the bill adopte[d] a single system of Federal statutory copyright from creation." Committee on the Judiciary, House Report No. 94-1476, *reprinted in* 17 U.S.C.A. § 301 (West 1989). *See also Roth v. Pritikin*, 710 F.2d 934, 938-39 (2nd Cir.), *cert. denied*, 464 U.S. 961 (1983) (legislative history). Part and parcel of this new federal copyright scheme was the express preemption provision of 17 U.S.C.

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[2] Art. I, § 8, cl. 8 of the U.S. Constitution has served as the source of federal authority to promulgate copyright law, empowering Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *See Sears, Roebuck & Co. v. Stiffel Company*, 376 U.S. 225, 228, *reh'g den.* 376 U.S. 973 (1964).

§ 301, which, through its terms and the legislative history surrounding its enactment, "makes clear a congressional intent to preempt previous law and replace the labyrinth of statutory and common law authority with a single, generally applicable federal statute." *Roth v. Pritikin*, 710 F.2d at 938.

The scope of federal copyright protection extends to "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 102(a). Included within the protection of the Copyright Act are products of authorship such as literary, musical, or dramatic works, *id.* at § 102 (a), as well as compilations and derivative works, *id.* at § 103. Compilations and derivative works are defined as works "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." *Id.* at § 101. However, facts, ideas, and concepts themselves are not provided copyright protection. 17 U.S.C. § 102(b); *see Financial Information Inc. v. Moody's Investors Service Inc.*, 808 F.2d 204, 207 (2nd Cir. 1986), *cert. denied*, 108 S.Ct. 79 (1987).

Plaintiff owns a registered copyright to the MCAT and many of the MCAT-related studies which are subject to the disclosure provisions of the State Act. "Section 106 of the Copyright Act confers a bundle of *exclusive* rights to the owner of the copyright. Under the Copyright Act, these rights—to publish, copy, and distribute the author's work—vest in the author of an original work from the time of its creation." *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 547 (1985) (emphasis added).[3]

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[3] The text of 17 U.S.C. § 106 ("Exclusive rights in copyrighted works") reads in applicable part as follows:

Simply put, plaintiff claims that the State Act interferes with its exclusive federal rights.

There are, however, statutory exceptions to the copyright owner's rights, *see* 17 U.S.C. §§ 107-118, two of which have been raised by the defendants in response to plaintiff's copyright claims. The first affirmative defense is raised pursuant to section 107 which "codifies the traditional privilege of other authors to make 'fair use' of an earlier writer's work." *Harper & Row*, 471 U.S. at 547. The second affirmative defense is raised pursuant to section 108 of the Copyright Act (entitled "Limitations on exclusive rights: Reproduction by libraries and archives") which permits archives to engage in limited reproduction and distribution of copyrighted works. The archive provision is potentially relevant due to a 1980 amendment to the State Act which designates the State Education Department an archive with respect to standardized tests. *See* N.Y. Educ. Law § 342(7).

IV. Factual Background

The assertions made in plaintiff's statement of "material facts as to which there is no genuine issue," submitted pursuant to Local Rule 10(j) of the Northern District of New York, have gone largely undisputed by the defendants. Defendants' 10(j) statement, on the other hand, lists a number of issues, for the most part legal in nature, which they believe must be resolved at a trial.

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies of phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending . . . .

The defendants do, however, submit an affidavit from their expert witness, Dr. Walter Haney, in which some of the factual assertions presented by the plaintiff are contested to some degree.

Plaintiff, the American Association of Medical Colleges, is a non-profit association whose members include numerous colleges of medicine, teaching hospitals, academic societies, and individuals. One aspect of AAMC's activities is the sponsorship of the Medical College Achievement Test. The MCAT is widely used by medical colleges as a measure of the academic achievement of applicants to their institutions. According to the defendants, this exam acts, more or less, as a "gatekeeper" to medical school. The MCAT tests potential medical students on 54 academic subtopics which the AAMC believes to be relevant when determining an individual's potential for success in medical school. Approximately 3,170 examinees in 32 test centers took the MCAT in New York in 1987. Beyond the MCAT itself, the AAMC also authors and commissions various MCAT related studies as part of its sponsorship and continued development of the exam. The AAMC asserts, and the defendants do not dispute, that the development of quality exams involves significant investments of both time and money.

The plaintiff makes extensive efforts to keep the MCAT secure from disclosure to the general public. It is undisputed that the AAMC neither publishes nor distributes the MCAT beyond the administration of the exam to examinees. Stringent security measures govern the assembly, printing, and distribution of the test booklets, admission to test centers, and collection and accounting of test booklets. The AAMC owns copyrights in the MCAT test forms, test questions, and answer sheets, as well as in some of the MCAT-related studies which contain past or potential MCAT questions. An important fact is that the AAMC frequently re-uses test questions from past exams. All these copyrighted documents would be made

available to review by the general public if the AAMC was required to comply with the disclosure provisions of N.Y. Educ. Law §§ 341, 341-a, and 342. However, MCAT test questions which have yet to be used in the actual calculation of an examinee's grade would not be subject to disclosure. A detailed description of the MCAT, including the process by which it is developed and administered, is contained in *Association of American Medical Colleges v. Mikaelian*, 571 F.Supp. 144, 145-48 (E.D.Pa. 1983), *aff'd*, 734 F.2d 3 (3rd Cir. 1984). The description found in *Mikaelian* is largely consistent with the undisputed facts presented to this court.

Plaintiff's central factual assertion is that disclosure of MCAT test questions would make impossible the reuse of test questions—thereby diminishing or destroying the value of these documents. In response, the defendants' expert witness forwards the opinion that "under certain circumstances it is entirely possible that previously disclosed [questions] might be validly reused." *Affidavit* Haney, par. 5-6. This would be so, according to Dr. Haney, in situations where there is a broad disclosure of test questions which, over time, would dilute the available market of practice questions so much so that selected past questions could be used again. Plaintiff, for its part, asserts flatly that no disclosed questions could or would be reused.

There is also some contention between the parties over whether the disclosure of the test questions would seriously deplete a "finite pool" of potential test questions—particularly with respect to the areas of general science. The defendants also point out that test agencies which administer other standardized tests, such as the Law School Admissions Test and Scholastic Aptitude Test, have complied with the Act's disclosure requirement without causing any serious injury to the quality of those exams. The parties also dispute the degree to which disclosure of the text of the MCAT will harm the AAMC's ability to

equate the results of one exam with that of past exams—apparently an important criterion in evaluating the accuracy of a standardized test over time. Of course, all properly disputed factual issues must be viewed in the light most favorable to the party opposing summary judgment. In any event, plaintiff asserts that the fact that the State Act will cause disclosure of the copyrighted MCAT questions, with a result that the AAMC will not be free to reuse these questions on later exams, is the key undisputed fact which will allow this court to grant summary judgment as a matter of law.

V. Discussion

Summary Judgment Standard

It is appropriate to grant summary judgment when the record viewed in the light most favorable to the nonmoving party presents a situation where there "is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986); *United States v. Diebold, Inc.*, 369 U.S. 654, 655 (1962). To survive such a motion, the party opposing summary judgment must provide the court with " 'concrete evidence from which a reasonable [trier of fact] could return a verdict in his favor.' " *Dister v. Continental Group, Inc.*, 859 F.2d 1108, 1114 (2nd Cir. 1988) (quoting *Anderson v. Liberty Lobby*, 477 U.S. at 256).

Federal Preemption

Under the Supremacy Clause of the United States Constitution,[4] the authority of state law must yield to validly

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[4] The Supremacy Clause, U.S. Const. Art. VI, cl. 2. states:

> This Constitution and the Laws of the United States . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

enacted federal statutes and regulations with which state law conflicts. This has generally been termed federal preemption. Plaintiff asserts numerous legal theories under which it believes the disclosure provisions of the Standardized Testing Act should be held invalid as preempted by federal law. The Second Circuit, in *Darling v. Mobil Oil Corp.*, 864 F.2d 981 (2nd Cir. 1989), recently summarized the various ways in which federal law can preempt state law. The court stated:

> Under the Supremacy Clause of Article VI federal law may preempt state or local law in at least three ways. . . . First, Congress may in express terms declare its intention to preclude state regulation in a given area. . . Second, in the absence of an express declaration, preemption may be implied when the federal law is "sufficiently comprehensive to make reasonable the inference that Congress 'left no room' for supplementing state regulation." . . . Of course, "courts should not lightly infer preemption." . . . Finally, state law may be preempted "to the extent that it actually conflicts with a valid federal statute." . . . "Conflict preemption" may occur either when "compliance with both federal and state regulations is a physical impossibility," . . . or where state law "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." . . .
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> A determination that federal law preempts a state statute should be reached in a careful and judicious manner to avoid unwarranted disruption of important state policies. . . . In areas traditionally regulated by state law, "we start with the assumption that the historic police powers of the States were not superseded by the Federal Act unless that was the clear and manifest purpose of Congress."

Id. at 985-86 (citations omitted). With respect to the particular issue before this court, it is clear that "a state

may neither abrogate nor in any way diminish the federally granted and protected rights of a copyright holder." *Mills Music, Inc. v. Arizona*, 591 F.2d 1278, 1285 (9th Cir. 1979); *see also Bell v. Combined Registry Co.*, 397 F.Supp. 1241, 1245 (N.D. Ill. 1975) ("the operation of state law cannot defeat the validity of a federal copyright"), *aff'd* 536 F.2d 164 (7th Cir.) *cert. denied*, 429 U.S. 1001 (1976); 17 U.S.C. § 201.[5]

Conflict Preemption and Federal Copyright

The AAMC asserts that the most clear cut legal basis upon which this court could find the disclosure provisions of the State Act preempted is what has been termed "conflict preemption." This type of preemption "may occur either when 'compliance with both federal and state regulations is a physical impossibility,'. . . or where state law 'stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." *Darling v. Mobil Oil Corp.*, 864 F.2d at 985-86. The federal copyright and patent law is "the supreme law of the land. . . . When state law touches upon the area of those federal statutes, it is 'familiar doctrine' that the federal policy 'may not be set at naught, *or its benefits denied*' by state law." *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964) (emphasis added, cita-

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[5] Courts have been willing to hold state laws invalid as preempted by the Federal Copyright Act on numerous occasions. *See e.g., Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 710-11 (1984) (Oklahoma statute that banned cable operators from carrying out-of-state alcoholic beverage advertising preempted by federal law because, among other things, the state statute interfered with right granted cable operators by the Copyright Act.); *Financial Information Inc., v. Moody's Investors Service*, 808 F.2d 204, 208 (2nd Cir. 1986), *cert. denied*, 108 S.Ct. 79 (1987) (publisher's state law misappropriation claim preempted by Copyright Act); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 53 (2nd Cir.), *cert. denied*, 476 U.S. 1159 (1986) (state law cause of action for unfair competition is preempted by the federal copyright laws to the extent it seeks protection against copying of a book).

tions omitted). Just as a "State cannot encroach upon the federal patent law directly," *id.* at 231, it may not encroach upon federal copyright law. *See Goldstein v. California*, 412 U.S. 546, 559 (1973) (with respect to copyright laws, a State may not "[attempt] to protect that which Congress intended to be free from restaint or to free that which Congress ha[s] protected"). *See also* 1 *Nimmer on Copyright*, § 101 [B] at 1-12 n. 43.2 ("A state law is preempted whether it 'creates, grants or destroys' rights which are 'equivalent' to the exclusive rights of copyright"). Therefore, a state law which safeguards or injures property rights protected by the Federal Copyright Act is preempted. It is plaintiff's position that the New York Act is preempted because it operates to deny the AAMC benefits which are conferred by 17 U.S.C. § 106 of the Federal Copyright Act.[6]

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[6] There are the numerous instances in which state law has been declared invalid as preempted by federal patent law. It is "appropriate to refer" to patent cases when conducting an analysis under the Copyright Act due to "the historic kinship between patent law and copyright law." *Sony Corp. v. Universal City Studies, Inc.*, 464 U.S. 417, 439 (1984). Recently, the Supreme Court held a Florida statute, which prohibited the use of a particular manufacturing process in the duplication of unpatented boat hulls, invalid as preempted by federal patent law. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 109 S.Ct. 971 (1989). The Court held that the state law operated to regulate an area which Congress decided to leave free to open competition—that is, the full use by all of ideas and designs which are unpatented or unpatentable, and therefore within the public domain. *See also Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) (Illinois unfair competition law preempted by patent law because copied article was unpatentable and thus could be "made and sold by whoever chooses to do so," *id.* at 231.); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 84 (1964) (same). However, the *Bonito Boats* court was careful to point out that state laws, such as those which prevent deceptive simulation of another's product so as to prevent consumer confusion or protect trade secrets, are proper exercises of state authority so long as the "nature and degree of state protection does not conflict with federal policies." 109 S.Ct. at 979-80.

Subject Matter of Copyright

As an initial matter it is clear to the court that the MCAT and the various MCAT related reports and studies, which have been copyrighted by the plaintiff and which are subject to disclosure under the New York Truth in Testing Act, N.Y. Educ. Law §§ 341, 341-a, and 342, are well within the "subject matter" of the Federal Copyright Act of 1976. *See* 17 U.S.C. §§ 102 and 103 (discussed previously); *Association of American Medical Colleges v. Mikaelian*, 571 F.Supp. 144, 150 (1983) *aff'd*, 734 F.2d 3 (3rd Cir. 1984) (finding that the MCAT is within the subject matter of Federal Copyright law); *see also Educational Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3rd Cir. 1986) (Scholastic Aptitude Test and Achievement Test are "original works of authorship" within the meaning of federal copyright laws. 17 U.S.C. § 102(a) and "compilations" within the meaning of § 103); *National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 484 n.6 (7th Cir.) (the Multistate Bar Exam, as "confidential creative material," was a "secure test" to which it was likely that "Congress intended the Copyright Act to afford protection"), *cert. denied*, 464 U.S. 814 (1983); *Applied Innovations Inc., v. Regents of the Univ. of Minn.*, 876 F.2d 626, 635 (8th Cir. 1989) (psychological tests within the subject matter of copyright). The rationale and reasoning presented in these cases leads this court to conclude that the studies and research reports which have been copyrighted by the AAMC and which contain MCAT exam questions are within the subject matter of the Federal Copyright Act. The defendants have not contested plaintiff's assertion that the AAMC has complied with the Copyright Act's registration requirements. *See* 17 U.S.C. § 408. Since this court has found the MCAT materials to be within the subject matter of copyright, to the extent defendants contend that the MCAT material is somehow not validly copyrighted, their contention is rejected.

State Law Conflicts With § 106 Rights

The MCAT and the MCAT-related research reports are within the subject matter of federal copyright law. Moreover, it is not disputed that the AAMC owns valid copyrights to this material. Therefore, barring a statutory exception, 17 U.S.C. § 106 will confer upon the plaintiff the exclusive right to publish, copy, and distribute these materials, as well as to prepare derivative works with respect to these documents. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 547 (1985). The dictates of the Standardized Testing Act would interfere with the AAMC's exclusive ownership rights as outlined in § 106 of the Federal Copyright Act. As already discussed, the New York statute will require the AAMC as owner of a copyrighted standardized test to disclose an exam which it wishes to retain as confidential. The State Act will also make the disclosed MCAT materials "public records" with respect to New York's Freedom of Information Law, and therefore subject these documents to reproduction and disclosure to members of the public. As such, unless the disclosure provisions of the New York statute fall into an exception to the exclusive rights of a copyright owner, those provisions will directly conflict with federal law and thereby be preempted. Defendants' central contention is that "New York's Standardized Testing Act does not conflict with and frustrate the objectives of federal law, because it is tailored to fit within the fair use and archive exceptions of the Copyright Act." Defendants' Mem. at 15.

The Fair Use Defense

The defendants contend that the disclosure required by the Standardized Testing Act is properly characterized as a fair use. As such, the State Act cannot be preempted —the "use" being within a statutory exception to the exclusivity of ownership rights outlined in 17 U.S.C. § 106. If the disclosure required by the State Act con-

stitutes a "use" within the "fair use" exception of § 107 of the Federal Copyright Act, then the State Act does not conflict with, and is not preempted by, federal copyright law. The drafters of section 107 viewed the fair use exception to the Copyright Act as an affirmative defense; the party asserting the exception, therefore, bears the burden of production and persuasion to show that the exception applies. *See Harper & Row*, 471 U.S. at 561; *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1255 (2nd Cir. 1986), *cert. denied*, 107 S.Ct. 2201 (1987); *Mikaelian*, 571 F.Supp. at 151.

Section 107 ("Limitations on exclusive rights: Fair use") states:

> Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes *such as criticism, comment*, news reporting, teaching (including multiple copies for classroom use), scholarship, or *research*, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
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> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
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> (2) the nature of the copyrighted work;
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> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
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> (4) the effect of the use upon the potential market for or value of the copyrighted work.

(Emphasis added). "The factors enumerated in [section 107] are not meant to be exclusive: '[S]ince the doctrine [of fair use] is an equitable rule of reason, no generally

applicable definition is possible, and each case raising the question must be decided on its own facts." *Harper & Row*, 471 U.S. at 560; *see also Iowa State Univ. Research Foundation v. American Broadcasting*, 621 F.2d 57, 60 (2nd Cir. 1980).

The issue of whether a use of a copyrighted work is a fair use "is a mixed question of law and fact." *Id.* As a result, "the appraisal of these four factors in a particular case is obviously a fact specific inquiry for which summary judgment is ill-suited." *Diamond v. Am-Law Publishing Corp.*, 745 F.2d 142, 147 (2nd Cir. 1984) (citing *DC Comics v. Reel Fantasy, Inc.*, 696 F.2d 24 (2nd Cir. 1982)). However, "[c]ourts in this Circuit have approved the resolution of the fair use question at the summary judgment stage on several occasions." *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1258 (2nd Cir. 1986) (finding in favor of a party who had raised a fair use defense), *cert. denied*, 107 S.Ct. 2201 (1987). "'[T]he mere fact that a determination of the fair use question requires an examination of the specific facts of each case does not necessarily mean that in each case involving a fair use there are facts *to be tried*.'" *Id.* (quoting *Meeropol v. Nizer*, 417 F.Supp. 1201, 1208 (S.D.N.Y. 1976)).

As a general matter the fair use doctrine operates to permit uses of copyrighted material to which a "reasonable copyright owner would have consented." *Harper & Row*, 471 U.S. at 550. It is an "equitable rule of reason," *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. at 448, which "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Iowa State Univ. Research Foundation*, 621 F.2d at 60. When analyzing a fair use issue courts have generally employed the four-part statutory analysis contained in § 107. As an initial matter, however, it is clear that the "use" envisioned by the disclosure provisions of

the State Act would be for one of the activities enunciated in section 107, that is, for "criticism," "comment," or "research." Therefore, the 'use' to which the State of New York would put the MCAT materials is for a purpose that meets with the threshold requirement set out in § 107's introductory paragraph.

Fair Use Cases. The tension between the Copyright Act's dual goals of greater access to information and its provision for exclusivity of ownership rights makes the question of fair use " 'the most troublesome in the whole law of copyright.' " *Maxtone-Graham v. Burtchaell*, 803 F.2d at 1255 (quoting *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2nd Cir. 1939)). Therefore, as a predicate to the four-part analysis it is helpful to review some of pertinent cases which have applied the fair use doctrine.

Commercial infringement on the AAMC's copyright in the MCAT was addressed in *Association of American Medical Colleges v. Mikaelian*, 571 F.Supp. 144 (E.D.Pa. 1983), *aff'd*, 734 F.2d 3 (3rd Cir. 1984). There, the same plaintiff as the one in the present action claimed copyright infringement by an individual who was engaged in the business of preparing students to take the MCAT. The court found clear, if not overwhelming, evidence that defendant Mikaelian had made verbatim copies of hundreds of MCAT exam questions and distributed them to persons enrolled in his course. The court held that the MCAT was within the subject matter of federal copyright law and that the owners of the MCAT copyright were entitled, pursuant to § 106, to the exclusive rights of ownership. Despite finding that it was highly unlikely that the commercial use to which the defendant sought to subject the MCAT was even covered by the fair use doctrine, the court went on to consider and reject the defendant's fair use defense. The court held that the commercial nature of the defendant's use, the massive size of the appropriation of MCAT material, the strict secu-

rity employed to prevent test disclosure, the unfair advantage conferred upon those students in the test coaching course, and the destruction in the value of the copyrighted materials, were strong factors weighing against a finding of fair use. *Id.* at 152-53. A similar analysis is found in *Educational Testing Services v. Katzman*, 793 F.2d 533 (3rd Cir. 1986), with respect to a test-coaching company's use of copies of the Scholastic Aptitude Test and the Achievement Tests.

The most comprehensive Supreme Court decision concerning the fair use doctrine is *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539 (1985). There the Court held that a news magazine's use of approximately 300 words from the *unpublished* manuscript of President Ford's autobiography constituted a copyright infringement to which the fair use doctrine did not apply. The 300-word excerpt from the book-length manuscript was found to have been the "heart" of the book, publication of which directly injured the marketability of the document. *Id.* at 569. However, the Court in *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), held that the manufacturer of video tape recorders could not be held liable for copyright infringement. The noncommercial taping of copyrighted television programming for home use was found to be a "fair use" of the material. In *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691 (1984), an Oklahoma statute that banned cable operators from carrying out-of-state alcoholic beverage advertising was held to be preempted by federal law because, among other things, the state statute interfered with rights granted cable operators by the Copyright Act. *Id.* at 710-11.

A lively debate was touched off by the Second Circuit's recent decision in *New Era Publications Int'l. v. Henry Holt & Co.*, 873 F.2d 576 (2nd Cir.), *reh'g* and *reh'g in banc denied*, 884 F.2d 659 (2nd Cir. 1989). The plaintiff in *New Era* held a copyright in the published and un-

published writings of L. Ron Hubbard, the founder of the Church of Scientology. The defendant published a scathing biography of the late Mr. Hubbard which included extensive reproduction of Hubbard's published and unpublished writings. Defendant responded to plaintiff's claim of copyright infringement by raising the defense of fair use. The district court held that the vast majority of the copied material was fairly used—with money damages, rather than an injunction, granted as a remedy for that small portion of unpublished copyrighted material which was found to be outside of the fair use exception. The panel majority affirmed the district court's decision on the basis of laches. However, the panel majority went on to express strong "disagreement with a great deal of what is said in the [lower court's] opinion" concerning the doctrine of fair use as it applied to unpublished material. *New Era*, 873 F.2d at 583.

With respect to the first fair use factor, the "purpose and character of the use," the *New Era* majority appeared to be of the opinion that differences in degree, that is, differences in the substance or importance of the work as viewed by the court, are of no weight in a fair use analysis. Rather, once the work can be classified as "criticism,' 'scholarship' or 'research" the analysis ends and the "factor cuts in favor of the book's publisher." *Id.*; *see also New Era*, 884 F.2d at 661 (concurrence in denial of rehearing *in banc*) ("If a book falls into one of these categories, assessment of the first fair use factor should be at an end"). In regard to the second fair use factor, "the nature of the copyrighted work," the panel majority stated that "unpublished works normally enjoy complete protection" and therefore, "[w]here use is made of materials of an 'unpublished nature,' the second fair use factor has yet to be applied in favor of an infringer." *New Era*, 873 F.2d at 583. The majority also found the second factor to weigh "heavily" in favor of the copyright holder. *Id.*

Notwithstanding the well reasoned concurrence in *New Era*, and the views expressed by a number of the judges of the Second Circuit that the fair use analysis contained in *New Era* is arguably dicta, *see New Era*, 884 F.2d at 662 (dissent from denial of rehearing *in banc*) the decision can properly be read as instructing district courts to give little extra regard to an "important" use—even one of great public benefit—beyond that given a work of "ordinary" comment and criticism. Moreover, absent extraordinary circumstance, works unpublished in nature are to receive complete copyright protection. While these narrow rules would appear to be inconsistent with an equitable nature of the fair use analysis, this court is bound to follow them.

Finally, in *Salinger v. Random House, Inc.*, 811 F.2d 90 (2nd Cir. 1987), the Second Circuit granted the plaintiff's request for a preliminary injunction barring the publication of a biography of the famous author. The *Salinger* court found that the manuscript quoted and paraphrased portions of the plaintiff's unpublished letters sufficient to constitute a violation of federal copyright law notwithstanding defendant's assertion of a fair use defense. *Id.* at 100. In making its determination, the court placed special emphasis on what it found to be the unpublished nature of the letters. *Id.* at 95-96. The letters were deemed to be unpublished even though they were kept by libraries through which the public could review the contents of the letters subject to restrictions of federal copyright law. *Id.* at 97.

Fair Use Analysis. In light of this background the court now turns to the four-factor fair use analysis.

A. Purpose of the Use. Congress requires courts to take into account "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes." 17 U.S.C. § 107 (1). "The nature of the interest at stake is highly relevant to whether a given use is fair." *Harper & Row,*

471 U.S. at 553. The fair use defense is more properly raised by litigants who use copyrighted material for non-commercial comment, research, and criticism, as opposed to those who employ such material in commercial, profit-oriented, activity. 17 U.S.C. § 107(1); *see Harper & Row*, 471 U.S. at 562 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 449 (1984) ("commercial use of copyrighted material is presumptively . . . unfair" while the "contrary presumption is appropriate" in the case of "noncommercial, nonprofit activity."); *Iowa State Univ. Research Foundation v. American Broadcasting*, 621 F.2d 57, 61 (2nd Cir. 1980); *Mikaelian*, 571 F.Supp. at 152-53.

The common name of the N.Y. Educ. Law § 340 *et seq.*, the "Truth in Testing Act," says much about its purpose. It is clear that the goal of the State Act is to subject the MCAT to non-commercial comment and criticism. The defendants assert that it is particularly important to subject the MCAT to disclosure because it is "not simply some literary creation over which AAMC claims exclusive ownership. It is a vehicle by which the AAMC exercises a monopoly over the screening process which determines the select few who are admitted to medical school." Defendants' Mem. at 13-14. The disclosure provisions, according to the defendants, are a legitimate exercise of police power to "open up" a process that has a major impact on the careers of many students. Furthermore, defendants assert that "[t]he law is intended to serve the public interest in the validity and objectivity of tests, to encourage development of better test instruments, and to assure the accuracy of the scoring process." Defendants' Mem. at 3.

With reference to N.Y. Educ. Law § 341-a, defendants also contend that the purpose of the use is to review whether the MCAT has a discriminatory impact on test takers who are women and minorities. Section 341-a of the State Act requires the AAMC to prepare statistical

reports on test performance with respect to race, sex, ethnicity, and linguistic background, and to provide the report to an advisory committee to the state legislature. Defendants assert that the State of New York has a clear interest, encompassed in "fair use" principles, which permits it to require the AAMC to develop and disclose reports which may expose a disparate impact on women and minorities who take the test.[7]

This court has determined, and plaintiff concedes, that the strong public purpose served by the Standardized Testing Act causes the first factor to cut clearly in favor of the defendants.

B. Nature of the Copyrighted Work. Generally, a copyrighted work which is both published and factual in nature is more properly subject to a fair use than an unpublished work that is fictional in nature, the "unpublished nature of a work . . . [being a] 'key though not necesarily determinative factor' tending to negate a defense of fair use" and "[t]he law generally recogniz[ing] a greater need to disseminate factual works than works of fiction or fantasy." *Harper & Row*, 471 U.S. at 554, 555, 563; *see also* 3 *Nimmer on Copyright* § 13.05, at 13-62, n. 2. With respect to works unpublished in "nature" the Supreme Court noted that a copyright owner's

[7] Plaintiff also asserts that the forced disclosure of the MCAT and MCAT-related material would be an involuntary governmental seizure of copyrighted material by the State of New York in violation of 17 U.S.C. § 201(e). Section 201(e) states:

> When an individual author's ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any government body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title.

While not reaching this issue, the unambiguous language of this provision supports plaintiff's position that a state, as any other individual, may not abrogate a copyright owner's federally protected rights. *See also Music Mills, Inc. v. Arizona*, 591 F.2d at 1286.

rights encompassed "not only the choice of "when," "where," and "in what form," to publish, but "whether to publish at all." *Harper & Row*, 471 U.S. at 564.[8] In *Educational Testing Services v. Katzman*, the Third Circuit held that the "unique nature of secure tests means that *any use* is destructive" of the copyright owner's rights under federal law. 793 F.2d 533, 543 (3rd Cir. 1986). In *National Conference of Bar Examiners v. Multistate Legal Studies*, the Seventh Circuit "agree[d] with the Register of Copyrights that the [Multistate Bar Exam] would probably be classified as an *unpublished* work under 17 U.S.C. § 101." 692 F.2d at 486 n.8 (emphasis added).

While admitting that the MCAT is an 'unpublished' work, the defendants assert that this court should not place too much emphasis on the published/unpublished distinction because that analysis was developed in cases which reviewed charges of infringement of works which were going to be made public at a later date. The plain-

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[8] Defendants also contend that the purpose of the State Act does not conflict with the central purpose of the Federal Copyright Act. As explained in *Sony Corp. of America v. Universal City Studios, Inc.*, this purpose is *not* "primarily designed to provide a special private benefit," 464 U.S. 417, 429 (1984), but rather, to benefit the *public* by "motivat[ing] the creative activity of the authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired." *Id.* (emphasis added); *see Harper & Row*, 471 U.S. at 545-46; *see also United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) ("The sole interest of the United States and the primary object in conferring the [copyright] monoply lie in the general benefits derived by the public from the labors of authors"). Here, the Federal Copyright Act is being used to keep 'creative work' secret. According to the defendants, holders of a copyright may not employ such material in a manner which has a major impact on an individual test taker's future, yet shield that same material from comment and criticism by the very persons whose careers are impacted by the MCAT. However, as stated in *Harper & Row*, one of the necessary effects of federal copyright law is that owners of copyrights will be able to keep their work secret.

tiff here, as defendants point out, is attempting to use the copyright laws to shield the MCAT from meaningful public scrutiny. This court agrees that it would be hard pressed to provide an example of an "unpublished" work which more deeply affects the lives and careers of individuals. And, though the MCAT is unpublished, it clearly is exposed to the public to a limited extent. Equitable considerations may operate to temper the generally powerful effect that the designation "unpublished" normally has on a fair use analysis. In *Salinger*, the Second Circuit was presented with a somewhat analogous situation. There, the famous author's unpublished letters could be reviewed by the public because the persons who received the letters placed them in libraries. The court found a biographer's use of quotations from and paraphrases of the letters *did not* constitute a fair use. In this manner the Second Circuit indicated that the unpublished nature of a work, even one exposed to the public for limited purposes, is still a factor weighing against fair use. This is so because the copyright owner "has a right to protect the expressive content of his unpublished writings for the term of his copyright." *Id.* at 100.

Defendants appear to argue that the AAMC's administration of the exam constitutes a first publication of the document and that therefore the state, by requiring disclosure subsequent to the administration of the exam, is not interfering with plaintiff's right of first publication. The argument misses the mark to the extent that courts have strongly endorsed the use of federal copyright law as a device to protect the privacy or secrecy of documents. *See Harper & Row*, 471 U.S. at 564.

Defendants also assert that the factual nature of the MCAT is a factor operating in favor of disclosure. It is true that "no author may copyright facts or ideas." *Harper & Row*, 471 U.S. at 547; *see* 17 U.S.C. § 102. However, "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality" which may be

copyrighted. *Id.* As previously noted, the MCAT is a creative compilation which fits well within the subject matter of federal copyright and is of the sort which has been protected from commercial infringement on many occasions. Simply because the MCAT employs facts in its questions does not operate against its status as a work which may be copyrighted.

Cognizant that "unpublished works normally enjoy complete protection" and that "[w]here use is made of materials of an "unpublished nature, 'the second fair use factor has yet to be applied in favor of an infringer," *New Era*, 873 F.2d at 583, this court finds that the second factor cuts in favor of the plaintiff.

C. Amount and Substantiality of the Portion Used. The third statutory factor directs the court to "examine the amount and substantiality of the portion used in relation to the copyrighted work as a whole." *Harper & Row*, 471 U.S. at 564. Both parties agree that the disclosure provisions of the State Act would cause most of the copyrighted material to be subject to a 'use' be it a fair use or not. The defendants admit that this factor leans in favor of the plaintiff, but notes that the state Act only requires disclosure of questions actually used in calculating the raw score of an examinee—permitting the continuation of AAMC's practice of field testing proposed, non-graded, questions without risk of disclosure.

In *Harper & Row*, the Supreme Court held that copying 300 words from a book-length manuscript, though normally an insubstantial portion, was substantial in that particular instance because defendant copied the "heart" of the document. 471 U.S. at 565. In *Iowa State University Research Foundation*, the Second Circuit found that an appropriation of only 8% of a film was a significant use with respect to a fair use analysis. 621 F.2d 57, 61 (2nd Cir. 1980). However, as noted by the Second Circuit:

> There are no absolute rules as to how much of a copyrighted work may be copied and still be considered a fair use. In some instances, copying a work wholesale has been held to be a fair use, *Sony Corp.; Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 203 Ct.Cl. 74 (1973), *aff'd* (per curiam), 420 U.S. 376, 95 S.Ct. 1344 (1975), while in other cases taking only a tiny portion of the original work has been held unfair.

Maxtone-Grahm v. Burtchaell, 803 F.2d at 1263 (finding that use of 4.3% of published book was "not incompatible with fair use").

This court is compelled to find that the third factor operates strongly in favor of the plaintiff. The disclosure provisions require the AAMC to make available to the general public, as "public documents," all former MCAT test questions. The disclosure provisions are very broad, containing no limitation as to who may view the materials or the period over which exams must be disclosed. This court could envision a more narrowly tailored disclosure, particularly with respect to the advisory committee's review of the potential for bias in standardized testing, that might well be compatible with fair use; however, the scope of the forced disclosure of unpublished, copyrighted material dictated by the State Act, clearly is not.

D. Effect on the Market. The last statutory factor focuses on the "effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107(4). "This last factor is undoubtedly the single most important element of fair use" . . . and, " 'when properly applied [to a fair use analysis], is limited to copying by others which does not materially impair the marketability of the work which is copied.' " *Harper & Row*, 471 U.S. at 566-67 (citing 3 *Nimmer on Copyright* § 13.05[A], at 13-76, quoting 1 *Nimmer* § 1.10[D], at 1-87). The framework for analyzing this factor was thoroughly set out in

Sony Corp. v. Universal City Studios, Inc., where the Supreme Court stated:

> The purpose of copyright is to create incentives for creative effort. Even copying for noncommercial purposes may impair the copyrignt holder's ability to obtain the rewards that Congress intended him to have. But a use which has no demonstrable effect upon the potential market for, or value of, the copyrighted work need not be prohibited in order to protect the author's incentive to create. The prohibition of such noncommercial uses would merely inhibit access to ideas without any countervailing benefit. . . . A challenge to a noncommercial use of a copyrighted work requires proof either that the particular use is harmful, or that if it should become widespread, it would adversely affect the potential market for the copyrighted work. Actual present harm need not be shown . . . . Nor is it necessary to show with certainty that future harm will result. What is necessary is a showing by a preponderance of the evidence that *some* meaningful likelihood of future harm exists. If the intended use is for commercial gain, that likelihood may be presumed. But if it is for a noncommercial purpose, the likelihood must be demonstrated.

464 U.S. at 450-51; *see also Harper & Row*, 471 U.S. at 568.

The AAMC asserts that both the copyrighted MCATs and MCAT-related studies will be "harmed" if it is required to comply with the State Act's disclosure provisions. This injury is in addition to that which plaintiff claims would inure to its ownership rights under federal copyright law; that is the "exclusive" right to reproduce or copy copyrighted works and to distribute them by sale or transfer, to prepare derivative works and to display copyrighted works publicly. *See* 17 U.S.C. § 107. In plaintiff's view the marketability of copyrighted MCAT material would be destroyed because the questions and

question "stimulus"—the fact pattern on which a question is based—could not be reused on subsequent exams. At oral argument counsel for AAMC stated flatly that no portion of disclosed MCAT questions would be reused since examinees who had read the questions would have an unfair advantage over those who had not.

This assertion is supported with extensive record evidence: Mitchell Aff. at pars. 26-29; Shepard Dep. at 26-27; Stancavage Dep. at 37-39; Wilson-Pessano Dep. at 87-88, 99-100; Plaintiff's Mem., Ex. 4 at 2 and Ex. 5 at 8. As previously noted, the plaintiff believes that the only salient fact necessary for a finding that the fourth factor favors the AAMC is that disclosure of the test questions would prevent their reuse. The Third Circuit has held that public disclosure of standardized tests such as the Scholastic Aptitude Test and Achievement Tests would "render the material worthless" to the copyright holder. *Katzman*, 793 F.2d at 543. The plaintiff also maintains, and defendants do not dispute, that the development of effective questions costs a good deal of both time and money—an investment which would be lost with disclosure.

Defendants' assertion that the marketability of the copyrighted material would not be affected is, at best, irresolute. Essentially, defendants put forward a theory that if the *plaintiff* took certain steps *some* of the questions, over time, could be reused. After ten years of discovery it behooves the defendants to come forward with more substantial "concrete evidence," *Anderson v. Liberty Lobby*, 477 U.S. at 256, as to their position on this material fact than the equivocal opinion of their expert. Without more, this court is well positioned to find on summary judgment that disclosure of the MCAT test questions would prevent them from being reused by the plaintiff. Therefore, the plaintiff has demonstrated "that *some* meaningful likelihood of future harm [to the

potential market for the copyrighted work] exists." *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. at 51.

Defendants also contend that the State Act does not force the plaintiff to disclose the MCAT materials, but rather presents the AAMC with a choice: avoid disclosure by not administering the exam within New York or administer the MCAT within New York and be subject to the State's disclosure requirements. This argument, while of potential use in situations where the State is seeking to regulate an area left open by the federal government, has no merit when the state law is preempted by the federal law pursuant to the Supremacy Clause. A state may not answer an assertion of federal rights with the reply that one should go elsewhere to exercise those rights. *Cf. Capital Cities Cable v. Crisp*, 467 U.S. at 711.

To the extent that the defendants assert that AAMC should, with proper effort, be able to create new equally valid test questions at a rate sufficient to replace the disclosed test questions their argument must fail. Congress has found that there is a public interest served by the copyright protections found in § 106. Therefore, plaintiff generally is not required to change its operations when another individual or entity is interfering with its ownership rights under the Federal Copyright Act in order to make the fair use exception fit. *Association of American Medical Colleges v. Mikaelian*, 571 F.Supp. at 155. This court finds that the fourth fair use factor also operates in favor of the plaintiff. The broad disclosure of the MCAT test questions dictated by the Standardized Testing Act would seriously impair or even destroy the value of the copyrighted exams.

An additional factor supports a finding that the disclosure provisions of the State Act are preempted by federal copyright law. The disclosue provisions, while not necessarily conflicting with federal regulations, are at cross purposes with them. Pursuant to 17 U.S.C. § 408(c)

the Register of Copyrights[9] has issued regulations regarding "secure tests"—exams, such as the MCAT, which are non-marketed and "administered under supervision at specified centers on specific dates, all copies of which are accounted for and either destroyed or returned to restricted locked storage following each administration." 37 CFR § 202.20(b)(4). *See Mikaelian*, 571 F.Supp. at 150. To assist in maintaining the secrecy of exam questions the Register of Copyrights has promulgated 37 CFR § 202.20(c)(2)(iv)[10] which obviates the need for the Copyright Office to retain a copy of the secure tests after the administration of the exam. *See Educational Testing Services v. Katzman*, 793 F.2d 533, 538 (3rd Cir. 1986). The Seventh Circuit has found this regulation to be in accordance with the Copyright Act's intention to "afford protection to confidential creative material such as secure tests," *National Conference of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478, 484 n.6 (7th Cir. 1982), *cert. denied*, 464 U.S. 814 (1983), and thus validly promulgated under the Copyright Act. The existence of these regulations reveal that it is the considered opinion of the Register of Copyright that the Copyright Act of 1976 operates to protect secure tests from public disclosure and serves as further support for a finding that the State Act is preempted.

This court finds that three of the four fair use factors, as well as other equitable considerations, operate in favor

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[9] The Register of Copyrights is vested by Congress with the authority to administer federal copyright law. *Goldstein v. California*, 412 U.S. 546, 568-69 (1973).

[10] 37 CFR § 202.20(c)(2)(vi) states:

Tests. In the case of tests, and answer materiai for tests, published separately from other literary works, the deposit of one complete copy will suffice in lieu of two copies. In the cases of any *secure test the Copyright Office will return the deposit (i.e. the test itself) to the applicant promptly after examination*: Provided that sufficient portions, description, or the like are retained so as to constitute a sufficient archival record of the deposit. (Emphasis added).

of the plaintiff. The disclosure provisions of the Standardized Testing Act, therefore, do not constitute a fair use within the meaning of 17 U.S.C. § 107. Defendants' affirmative defense fails.

The Archive Exception 17 U.S.C. § 108

Having found that federal copyright law operates to prohibit the State of New York from forcing the AAMC to disclose the copyrighted MCAT and MCAT materials, this court need spend little time on the defendants' "archive" defense. As already noted, the New York State Legislature amended the Standardized Testing Act so that the State Education Department would be "considered an archive" with respect to the retention and copying of standardized tests. N.Y. Educ. Law § 342(7). The goal of this amendment was to "harmonize" the State Act with federal copyright law in a manner which would fit within the "archive" exception codified at 17 U.S.C. § 108. The archive clause operates as an exception to the exclusivity of ownership rights bestowed upon a copyright owner by permitting, under limited circumstances, the reproduction and distribution of copyrighted works by "archives" without threat of civil suit. Though there is no case law remotely on point, it is clear that this exception would only apply to unpublished works which are properly in the possession of an archive in the first place. *See* January 1988 Report of the Register of Copyrights on Library Reproduction of Copyrighted Works (17 U.S.C. 108) ("Congress did not intend subsections 108(d) and (e) to apply to the photocopying and distribution of unpublished works by libraries or archives for their patrons. . . . Once the copyright owner has made the choice not to publish, this choice must be honored."). Here, the State Act, if enforced, would cause the copyrighted materials to be placed with the designated archive against the will of the owner. If the archive could copy and distribute this material it could also copy and distribute any author's creative work, though unpublished, so long as the mate-

rials came into the archive's possession. This would be so even if the possession was by illegitimate means. Such a result would be totally at odds with the intent of Congress when enacting the Federal Copyright Act. On this basis the defendants' assertion that the State Act is somehow saved by operation of § 108 is rejected.

Conclusion

This court finds that the "disclosure provisions" of New York State's Standardized Testing Act, N.Y. Educ. Law §§ 341, 341-a and 342 are preempted due to a direct conflict with Federal Copyright Law. Therefore, this court shall issue a permanent injunction barring the defendants from enforcing the disclosure provisions of the Standardized Testing Act, N.Y. Educ. Law §§ 341, 341-a, and 342, from being enforced against plaintiff, the American Association of Medical Colleges. Plaintiff is directed to submit a proposed order to the court and to counsel for the defendants for review and comment. The court has considered plaintiff's request for attorneys fees and costs, and denies the same.

IT IS SO ORDERED.

DATED: January 12, 1990
Syracuse, NY

/s/ Neal P. McCurn
NEAL P. MCCURN
Chief, U.S. District Judge

APPENDIX E

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

79-CV-730

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff,

-v-

MARIO CUOMO, GOVERNOR OF THE STATE OF NEW YORK, *et al.*,
Defendants.

APPEARANCES:

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NEAL P. MCCURN, C.J.

FINAL JUDGMENT

[Filed Feb. 13, 1990]

The court has considered the motion for summary judgment filed by plaintiff Association of American Medical Colleges ("AAMC") and the cross-motion to dismiss certain claims filed by the defendants; the supporting memoranda, exhibits and affidavits filed by the respective parties; and the parties' oral arguments. Having done so,

and in accordance with the memorandum-Decision and Order filed by the court in this case on January 12, 1990, it is hereby

ORDERED, ADJUDGED AND DECREED that AAMC's motion for summary judgment be and hereby is granted in part; and it is further

ORDERED, ADJUDGED AND DECREED that New York Education Law §§ 341, 341-a and 342 (McKinney 1988) are preempted under the Supremacy Clause of the United States Constitution, United States Article VI, Clause 2, and by the Copyright Act of 1976, 17 USC § 101 *et seq.*; and it is further

ORDERED, ADJUDGED AND DECREED that the defendants, their agents, their employees, their attorneys, their successors, and all persons acting in concert with them, are permanently enjoined from enforcing §§ 341, 341-a and 342 of New York Education Law, in any way against AAMC or its agents, employees, attorneys, or successors; and it is further

ORDERED, ADJUDGED AND DECREED that the defendants' cross-motion to dismiss certain claims be and hereby is granted; and that final judgment is hereby entered dismissing the claims asserted by AAMC in Counts VII, VIII, X and XII of its amended complaint, all of which are based upon the Constitution of the State of New York, such dismissal being without prejudice to the assertion of such claims in an appropriate State Court; and it is further

ORDERED, ADJUDGED AND DECREED that each party shall bear its own costs, including attorneys' fees.

DATED: February 10, 1990
Syracuse, New York

/s/ Neal P. McCurn
NEAL P. MCCURN
Chief, U.S. District Judge

APPENDIX F

UNITED STATES DISTRICT COURT
N. D. NEW YORK

Civ. A. No. 79-CV-730

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff,

v.

HUGH L. CAREY, Individually, and as Governor; THEODORE M. BLACK, Individually, and as Chancellor, Board of Regents of the University of the State New York; WILLARD A. GENRICH, Individually, and as Vice Chancellor, Board of Regents of the University of the State of New York; KENNETH B. CLARK, Individually, and as Member, Board of Regents of the University of the State of New York; HAROLD E. NEWCOMB, Individually, and as Member, Board of Regents of the University of the State of New York; EMLYN I. GRIFFITH, Individually, and as Member, Board of Regents of the University of the State of New York; MARY ALICE KENDALL, Individually, and as Member, Board of Regents of the University of the State of New York; JORGE L. BATISTA, Individually, and as Member, Board of Regents of the University of the State of New York; LOUIS E. YAVNER, Individually, and as Member, Board of Regents of the University of the State of New York; LAURA BRADLEY CHODOS, Individually, and as Member, Board of Regents of the University of the State of New York; MARTIN C. BARELL, Individually, and as Member, Board of Regents of the University of the State of New York; JOSEPH R. BONGIORNO, Individually, and as Member, Board of Regents of the University of the State of New York; LOUISE P. MATTEONI, Individually, and as Member, Board of Regents, of the University of the State of New York; J. EDWARD MEYER, Individ-

ually, and as Member, Board of Regents of the University of the State of New York; ARLENE B. REED-DELANEY, Individually, and as Member, Board of Regents of the University of the State of New York; R. CARLOS CARBALLADA, Individually, and as Member, Board of Regents of the University of the State of New York; GORDON M. AMBACH, Individually, and as Commissioner of Education, University of the State of New York, and ROBERT ABRAMS, Individually and as Attorney General,

Defendants.

Jan. 22, 1980

DeGraff, Foy, Conway, Holt-Harris & Mealey, Albany, N.Y., Fulbright & Jaworski, Washington, D.C., for plaintiff; Carroll J. Mealey, Albany, N.Y., Carl W. Vogt, Joyce E. Reback, Washington, D.C., of counsel.

Robert Abrams, Atty. Gen. of the State of New York, Albany, N.Y., pro se and for all named defendants other than Bongiorno, Meyer, and Newcomb, individually & as members of the Board of Regents; Stanley Fishman, Maurice K. Peaslee, Asst. Attys. Gen., Albany, N.Y., of counsel.

MEMORANDUM-DECISION AND ORDER

McCURN, District Judge.

In this action for declaratory and injunctive relief, plaintiff, Association of American Medical Colleges, challenges the legality and constitutionality of certain provisions of the New York Standardized Testing Act, Article 7-A of the New York Education Law, as they apply to its Medical College Admission Test ("MCAT") and to unpublished studies, evaluations and reports pertaining to

the MCAT. The lawsuit is presently before the Court on plaintiff's motion for a preliminary injunction.[1]

Plaintiff is a non-profit educational association whose members comprise 125 United States Schools of Medicine, 418 teaching hospitals, 68 academic societies and over 1,700 individuals.

Defendant, Hugh L. Carey, is the Governor of the State of New York, and is being sued both individually and in his capacity as Governor.

Defendants, Black, Genrich, Clark, Newcomb, Griffith, Kendall, Batista, Yavner, Chodos, Barell, Bongiorno, Matteoni, Meyer, Reed-Delaney and Caraballada, are members of the Board of Regents of the University of the State of New York and are defendants in this action both individually and in their official capacity.[2]

Defendant, Gordon M. Ambach, is the Commissioner of Education for the State of New York and is named as a defendant both individually and in his official capacity.

Defendant, Robert Abrams, is the Attorney General for the State of New York and named as a defendant individually and as Attorney General.

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[1] Plaintiff's request for a temporary restraining order was denied at the January 7, 1980, argument on the preliminary injunction motion. The application was denied for failure by plaintiff to demonstrate the possibility of harm from enforcement of the Testing Act during the petition for which a temporary restraining order would be effective.

Argument on plaintiff's request for a temporary restraining order had originally been scheduled for December 28, 1979, but was adjourned by stipulation of the parties whereby defendants agreed not to enforce §§ 341 and 342 of the Act prior to January 7, 1980.

[2] At oral argument on the motion, defendants' counsel indicated that named defendants Batista, Bongiorno and Meyer had not been served. Affidavits of service filed with the Court, however, show service on both Batista and Meyer. An affidavit filed by a United States Marshall on December 28, 1979, indicates that although several attempts at service were made on Bongiorno, none were successful, and he has not been served.

Jurisdiction is alleged pursuant to 28 U.S.C. §§ 1331, 1338(a) and 1343(3). Declaratory relief is sought pursuant to 28 U.S.C. §§ 2201 and 2202.

BACKGROUND

On July 13, 1979, Governor Carey signed into Law Article 7-A of the Education Law, popularly referred to as the "Truth in Testing" Law. (N.Y.Ed. Law §§ 340 *et seq.*) Effective January 1, 1980, the Law applies to "any test that is given at the expense of the test subject and designed for use in the process of selection for post-secondary or professional school admissions." [N.Y. Ed.Law § 340(1)]. The MCAT given by plaintiff is specifically included under the Law. [§ 340(1)].

In addition to provisions which set forth various notice requirements (§ 343) and requirements for disclosure of test results by test agencies (§ 344), the Law imposes certain obligations on test agencies with regard to disclosure of studies, background reports and statistical data pertaining to the tests (§ 341)[3] and of the contents of the tests themselves (§ 342).[4] It is these last two provisions which plaintiff finds unacceptable.

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[3] N.Y. Education Law § 341 provides that:

1. Whenever any test agency prepares, causes to have prepared or provides the data which are used in any study, evaluation or statistical report pertaining to a test, such study, evaluation or report shall be filed with the commissioner.

2. If any reports or other documents submitted pursuant to this section contains information identifiable with any individual test subject, such information shall be deleted or obliterated prior to submission.

3. All data, reports or other documents submitted pursuant to this section shall be public records.

[4] The full text of Ed.Law § 342 reads as follows:

1. Within thirty days after the results of any standardized test are released, the test agency shall file or cause to be filed in the office of the commissioner:

a. a copy of all test questions used in calculating the test subject's raw score; b. the corresponding acceptable answers to those

Plaintiff alleges the advancement of medical education and health care in the United States as its sole reason for existence. In furtherance of this purpose plaintiff has, for almost fifty years, sponsored a testing program for medical school applicants. This program includes the development and administration of the MCAT.[5]

In connection with its sponsorship of the MCAT, plaintiff also prepares or causes to be prepared, on an ongoing basis, confidential unpublished studies, evaluations and reports pertaining to the MCAT. These include studies of the performance of graduates of particular undergraduate schools and reports consisting of evaluations of test subject's performance on individual questions for use in

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questions; and c. all rules for transferring raw scores into those scores reported to the test subject together with an explanation of such rules.

2. After the test has been filed with the commissioner, and upon the request of the test subject, the test agency shall send to the test subject: a. a copy of the test questions used in determining the subject's raw score; b. the subject's individual answer sheet together with a copy of the correct answer sheet to the same test with questions counting toward the subject's raw score so marked; and c. a statement of the raw score used to calculate the scores already sent to the subject, provided that such request has been made within ninety days of the release of the test score to the test subject. The agency may charge a nominal fee for sending out such information, not to exceed the direct cost of providing the information.

3. This section shall not apply to College Board Achievement Tests or GRE Advanced Tests.

4. Documents submitted to the commissioner pursuant to this section shall be public records.

[5] In April of 1977, plaintiff began administering a newly developed and allegedly improved MCAT. The new MCAT "consists of four sets of test questions which permit assessment in the following areas: (a) Biology; (b) Chemistry; (c) Physics; (d) Science Problems; (e) Skills Analysis; Reading: and (f) Skills Analysis: Quantitative." Affidavit of James B. Erdmann, Ph.D., Director of the Division of Educational Measurement and Research, Paragraph 4 (Exh. B to plaintiff's memorandum in support of the motion).

developing new questions. Both of these types of studies are prepared on a confidential basis.

Detailed security procedures govern all phases of development of the MCAT, including test book assembly, printing and distribution. Beginning with the April 1978 MCAT, plaintiff has registered every test form with the Register of Copyright in conformity with the deposit procedures set forth at 37 C.F.R. § 202.20(c)(2)(iv).[6]

In 1979, the MCAT was administered four times, on consecutive Saturdays and Sundays in the Spring and Fall at approximately 450 test centers throughout the world, including 26 in the State of New York. The test was taken by approximately 48,000 individuals, 5,000 of whom took the test in New York State. Plaintiff has indicated that a similar schedule had been planned for 1980. Plaintiff has made clear that it does not intend to administer the MCAT in New York State in 1980 if forced to comply with Sections 341 and 342 of the Testing Act.[7]

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[6] The MCAT is a secure test as defined at 37 C.F.R. § 202.20(b)(4) as:

"a nonmarketed test administered under supervision at specified [test] centers on specific dates, all copies of which are accounted for and either destroyed or returned to restricted locked storage following each administration. For these purposes a test is not marketed if copies are not sold but it is distributed and used in such manner that ownership and control of copies remains with the test sponsor or publisher."

37 C.F.R. § 202.20(c)(2)(vi) provides that:

"[i]n the case of tests, and answer material for tests, published separately from other literary works, the deposit of one complete copy will suffice in lieu of two copies. In the case of any secure test the Copyright Office will return the deposit to the applicant promptly after examination: *Provided*, that sufficient portions, description or the like are retained so as to constitute a sufficient archival record of the deposit."

[7] Upon consideration of plaintiff's position regarding the potential for destruction of the validity of the MCAT under the Law, the Court is convinced that plaintiff will so act. It should be noted in

DISCUSSION

In seeking to enjoin enforcement of Sections 341 and 342 of the "Truth in Testing" Law, plaintiff alleges that the Act violates the federal Copyright Act, and furthermore, that it is, in fact, preempted by the Copyright Act. Plaintiff also raises constitutional issues under both the United States and New York State Constitutions, alleging specifically a denial of due process and equal protection rights.

Claiming that it will suffer irreparable harm if forced to comply with the challenged provisions, plaintiff asks the Court to grant a preliminary injunction, enjoining enforcement of Sections 341 and 342 pending a determination on the merits.

Opposing the motion, defendants raise threshold jurisdictional questions concerning applicability of the Eleventh Amendment as a bar to this action, ripeness and whether proper defendants have been named in the action. In addition, defendants allege laches on the part of plaintiff in commencing this action, which according to defendants precludes issuance of a preliminary injunction.[8]

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this regard that plaintiff does not seek to avoid enforcement of the entire Act but rather two sections only.

[8] Laches may be found in equitable actions upon a showing of unreasonable delay in bringing an action with resulting undue prejudice to the defendant. See *R. Dakin & Co. v. A & L Novelty Co., Inc.*, 444 F.Supp. 1080, 1084 (E.D.N.Y.1978).

In the present action, although there is no doubt that plaintiff was aware of enactment of the Act in July 1979 and did not commence this action until November of 1979, there is no indication that plaintiff's delay was unreasonable, in light of evidence indicating attempts at negotiating changes in the Law which continued without success into November. Furthermore, it is questionable whether prejudice could be found in light of the fact that there is still a tremendous amount of controversy over the Law and amendments to the Law including one which would postpone the effective date of the statute, have already been introduced.

Jurisdiction

A.

Defendants, citing *Edelman v. Jordan*, 415 U.S. 651, 94 S.Ct. 1347, 39 L.Ed.2d 662 (1974) and *Alabama v. Pugh*, 438 U.S. 781, 98 S.Ct. 3057, 57 L.Ed.2d 1114 (1978), assert that the Eleventh Amendment to the Constitution bars this action against the State officials named as defendants.[9]

> The Eleventh Amendment provides that: "[t]he Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or Citizens or subjects of any Foreign State."

The principle of sovereign immunity embodied in the Amendment has been construed to extend to suits by private persons against State officials as well, when the action seeks to "impose a liability which must be paid from public funds in the state treasury . . . ," (*Edelman v. Jordan*, *supra*, 415 U.S. at 663, 94 S.Ct. at 1356) and such actions have consistently been barred.

Defendants' argument fails to recognize, however, that there has traditionally been a distinction made between suits against State officials in their official capacity which could result in liability to the State treasury, and those seeking only declaratory and injunctive relief against the officials. In fact, the latter has been the traditional means of challenging the constitutionality of a State enactment.

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[9] In *Edelman v. Jordan*, *supra*, an action against the Director of the Illinois Department of Public Aid, plaintiffs sought and were denied, on the basis of the Eleventh Amendment, retroactive recovery of public assistance benefits wrongfully withheld. In *Alabama v. Pugh*, *supra*, the Supreme Court held that the Eleventh Amendment barred an action against the State and its Board of Corrections, even though injunctive relief was involved. The action was allowed to stand as against the individual prison officials, however. Both cases are easily distinguishable from the present since in *Edelman* money damages were sought, and in *Alabama* the State itself was made a party.

In the landmark decision of *Ex parte Young*, 209 U.S. 123, 28 S.Ct. 441, 52 L.Ed. 714 (1908), the Supreme Court recognized the distinction, holding that a suit for declaratory and prospective injunctive relief could be maintined by a private party against a State official responsible for enforcement of an allegedly unconstitutional enactment.[10]

Plaintiff, in this action for declaratory and injunctive relief, has not overstepped the bounds of *Ex parte Young*, *supra*, and that being the case, the Eleventh Amendment does not serve as a bar to the present action.

B.

Defendants' claim that plaintiff has commenced this action prematurely is likewise without merit. Defendants' position, in opposing this motion, is that since none of the defendants has as yet threatened plaintiff with enforcement of the Testing Law, that the complaint is fatally defective, and that injunctive relief is clearly not warranted at this time.[11]

This position, however, flies in the face of well established judicial precedent which holds that a party need not await the occurrence of a threatened injury which

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[10] This principle has been reaffirmed repeatedly by the Supreme Court and followed innumerable times in the lower courts. *Cf. Quern v. Jordan*, 440 U.S. 332, 99 S.Ct. 1139, 59 L.Ed.2d 358 (1979); *Hutto v. Finney*, 437 U.S. 678, 98 S.Ct. 2565, 57 L.Ed.2d 522 (1978). See also *Hansbury v. Regents of Univ. of Cal.*, 596 F.2d 944 (10th Cir. 1979); *Trotman v. Palisades Interstate Park Com'n.*, 557 F.2d 35 (2d Cir. 1977); *Allah v. Com'r. of Dept. of Correctional Services*, 448 F.Supp. 1123 (N.D.N.Y.1978).

Recently, in *Ray v. Atlantic Richfield Co.*, 435 U.S. 151, 98 S.Ct. 988, 55 L.Ed.2d 179 (1978), the Supreme Court was asked to overrule *Ex parte Young, supra*, and declined to do so.

[11] Under the United States Constitution, Art. 3, § 2, the jurisdiction of the federal courts is limited to actual "cases or controversies." Defendants argue that since there has been no threat of enforcement, there is no controversy.

will result from enforcement of a statute under attack before being allowed to seek preventive relief. *Pierce v. Society of Sisters*, 268 U.S. 510, 45 S.Ct. 571, 69 L.Ed. 1070 (1925); *Commonwealth of Pennsylvania v. West Virginia*, 262 U.S. 553, 43 S.Ct. 658, 67 L.Ed. 1117 (1923). Furthermore, the Supreme Court has found it to be "irrelevant to the existence of a justiciable controversy that there will be a time delay before the disputed provisions will come into effect." *Regional Rail Reorganization Act Cases*, 419 U.S. 102, 143, 95 S.Ct. 335, 358, 42 L.Ed.2d 320 (1974).

There is no question but that plaintiff will be affected by the Testing Law if it continues to offer the MCAT in the State of New York, since as previously indicated, § 340(1) explicitly includes the MCAT as a "standardized test" subject to the Act. There being nothing indefinite with regard to the Act's application as to plaintiff, the Court clearly has before it a controversy which is ripe for determination.[12]

C.

Defendants' final jurisdictional challenge involves an assertion that the proper parties are not now before this Court. In this regard, defendants contend that the Governor and the Attorney General have no statutory authority to enforce the Education Law and are, therefore, improper parties to the proceeding.[13]

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[12] Defendants' reliance upon *Eccles v. Peoples Bank*, 333 U.S. 426, 68 S.Ct. 641, 92 L.Ed. 784 (1947) is completely misplaced since in that action, there was not only no threat of enforcement but an expression of intent on the part of the defendant that there would be no such attempt. Defendants herein have expressed no intent to decline enforcement of the law.

[13] Defendants also claim that this action cannot go forward without the presence of the Board of Regents as a named defendant. The Court disagrees. Each member of the Board has been named as a defendant in both his individual capacity and as a Board Mem-

In determining whether a particular State official is a proper party in an action to enjoin enforcement of a State law, the Court looks again to *Ex parte Young*, *supra*, in which the Court stated that:

> "[i]n making an officer of the State a party defendant in a suit to enjoin the enforcement of an act alleged to be unconstitutional, it is plain that such officer must have some connection with the enforcement of the act, or else it is merely making him a party as a representative of the state, and thereby attempting to make the state a party. It has not, however, been held that it was necessary that such duty should be declared in the same act which is to be enforced." 209 U.S. at 157, 28 S.Ct. at 453.

It appears clear that in order for the Governor and the Attorney General to be named as defendants in this action, some connection with the enforcement of Sections 341 and 342 must be demonstrated.

Sufficient connection is found for the Governor in the New York State Constitution, Art. 4, § 3 in which the Governor is charged with the duty to "take care that the laws are faithfully executed." This mandate has, in many other instances been found to provide the necessary

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ber. All but one of the Members has been served at this time, and the Board is clearly before the Court.

In any event, the Commissioner of Education, who apart from any action by the Board of Regents, is charged with the enforcement of the Education Law [Ed.Law § 305(1)], is before the Court as a defendant. See *Kinsella v. Board of Ed. of Cent. Sch. Dist. No. 7 Erie Cty.*, 378 F.Supp. 54 (W.D.N.Y.1974), aff'd without opinion 542 F.2d 1165 (2d Cir. 1976), in which the Commissioner of Education and not the Board of Regents was named as a defendant in a challenge to the constitutionality of a provision of the Education Law. There was no discussion as to whether the Board of Regents should have been named, but clearly it was not found to be a necessary party to the challenge.

basis [14] and the Court can see no reason why that should not be the case here. *Cf. Federal National Mortgage Ass'n v. Lefkowitz*, 383 F.Supp. 1294 (S.D.N.Y.1974); *Socialist Workers Party v. Rockefeller*, 314 F.Supp. 984 (S.D.N.Y.1970) aff'd 400 U.S. 806, 91 S.Ct. 65, 27 L.Ed. 2d 38 (1970).

The Court also finds that the Attorney General has been properly named as a defendant in this action. Defendants argue that the Attorney General has no express authority to enforce the Education Law, thereby making him an improper party. However, the duties of the Attorney General, which are set forth in the Executive Law § 63, include the duty to:

> "(1) [p]rosecute and defend all actions and proceedings in which the state is interested, and have charge and control of all the legal business of the departments and bureaus of the state, or of any office thereof which requires the services of attorney or counsel in order to protect the interest of the state . . . ."

and

> "(12) Whenever any person shall engage in repeated fraudulent or illegal acts or otherwise demonstrate persistent fraud or illegality in the carrying on, conducting or transactions of business, the attorney-general may apply, in the name of the people of the state of New York . . . for an order enjoining the continuance of such business activity or of any fraudulent or illegal acts."

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[14] In some cases Art. 4, § 3 has been found to be an insufficient connection. *Cf. Oliver v. Board of Education of City of New York*, 306 F.Supp. 1286 (S.D.N.Y.1969); *Camacho v. Rogers*, 199 F.Supp. 155 (S.D.N.Y.1961). However, it should also be noted that in numerous cases Governors have been accepted, without discussion, as defendants in challenges to State laws *Cf. Ray v. Atlantic Richfield Co., supra; St. Martins Press, Inc. v. Carey*, 440 F.Supp. 1196 (S.D.N.Y.1977).

While the Court is not prepared to state that the foregoing provisions would in every case provide a sufficient basis for making the Attorney General a defendant, they suffice in this instance. Although it is true that the Commissioner of Education has the duty to enforce the Education Law pursuant to § 305(1), in his initial impact statement on the Testing Law, dated October 16, 1979, Commissioner Ambach, while admitting an obligation to monitor compliance with the law, stated that violations would be brought to the attention of the Attorney General. Furthermore, the Court is aware that plaintiff does not look favorably upon the testing legislation and could conceivably choose to violate its provisions, in which case the Attorney General would be empowered to act under the Executive Law § 63(12) to enjoin the violations. See *Federal National Mortgage Ass'n. v. Lefkowitz, supra.*

Having determined that none of defendants' jurisdictional arguments is meritorious, the Court finds that jurisdiction is present in this action pursuant to 28 U.S.C. §§ 1331, 1338(a) and 1343(3) as alleged by plaintiff.

Standard for Issuance of a Preliminary Injunction

The standard in the Second Circuit for issuance of a preliminary injunction is that:

> "there must be a showing of possible irreparable injury *and* either (1) probable success on the merits *or* (2) sufficiently serious questions going to the merits to make then a fair ground for litigation and a balance of hardships tipping decidedly toward the party requesting the preliminary relief." *Buffalo Courier-Express, Inc. v. Buffalo Evening News,* 601 F.2d 48, 54 (2d Cir 1979) quoting from *Caulfield v. Board of Education of the City of New York,* 583 F.2d 605, 610 (2d Cir. 1978).

See also *Triebwasser & Katz v. American Telephone & Telegraph Co.,* 535 F.2d 1356, 1358 (1976).

The Court finds that in this case, the second criterion has been satisfied, warranting the issuance of a prelimi-

nary injunction enjoining enforcement of Sections 341 and 342 of the Education Law against plaintiff, pending a determination on the merits.

Sufficiently Serious Questions Going to the Merits

Plaintiff in this lawsuit has raised "serious questions going to the merits which warrant further investigation and trial." *Gulf & Western Indus., Inc. v. Great A. & P. Tea Co., Inc.*, 476 F.2d 687, 692 (2d Cir. 1973).

The federal Copyright Act of 1976 provides that copyright protection be conferred upon "original works of authorship fixed in any tangible means of expression, now known or later developed, from which they can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device." [17 U.S.C. § 102(a)]. Copyright protection attaches immediately upon creation of the work.

Plaintiff claims, and defendants do not vigorously dispute, that the MCAT and studies and reports related thereto are works which are entitled to protection under the Copyright Act.[15]

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[15] Defendants do, however, raise an issue concerning the fact that none of plaintiff's 1980 tests has as yet been registered. The Court might also point out that the unpublished studies and reports which plaintiff seeks to protect from infringement are apparently not, as a rule, registered by plaintiff.

Although copyright protection attaches to a work at the time of creation, an action for infringement can only be instituted if the work has been registered under the Copyright Act. (17 U.S.C. § 411). However, Courts have not hesitated to enjoin the infringement of future registered works when equity has required. *See Wainright Securities, Inc. v. Wall Street Transcript Corp.*, 418 F.Supp. 620 (S.D.N.Y.1976), aff'd on other grounds, 558 F.2d 91 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014, 98 S.Ct. 730, 54 L.Ed.2d 759 (1978); *Orth-O-Vision, Inc. v. Home Box Office*, 474 F.Supp. 672 (S.D.N.Y.1979).

While that should certainly be the case with regard to the tests, it is not so clear as to the studies which have never been registered. However, since plaintiff has also raised sufficiently serious legal

As holder of a copyright on the MCAT and related studies, plaintiff argues that it is entitled to the rights granted at 17 U.S.C. § 106 of the Copyright Act. These include the right to control the reproduction and distribution of the copyrighted work. [17 U.S.C. § 106(1) & (3)]. Plaintiff claims that these rights will be violated by Sections 341 and 342 of the Testing Law in that plaintiff, in order to comply, will be required under threat of civil penalty, to reproduce and distribute copies of the MCAT and will be required to file with the State, for public use, copies of the related studies.

In addition, plaintiff alleges that defendants, through enforcement of Sections 341 and 324, will engage in unauthorized reproduction and distribution of the MCAT and related studies since the tests and studies will become public documents pursuant to the Testing Law and thereby available to the public under the New York State Freedom of Information Act (Art. 6 of the N.Y. Public Officers Law §§ 84 *et seq.*). By engaging in unauthorized reproduction and distribution of plaintiff's copyrighted works, defendants will, according to plaintiff, be guilty of copyright infringement under 17 U.S.C. § 501(a).[16]

Defendants argue, however, that plaintiff fails to recognize that the use of the copyrighted material pursuant to Sections 341 and 342 of the Testing Law falls within the well established doctrine of "fair use", recently codified in the Copyright Act of 1976 at 17 U.S.C. § 107.[17] "Fair use" has been defined as:

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issues concerning preemption and constitutional violations, the Court is not precluded from granting injunctive relief as to the studies because of failure to register.

[16] Support can be found for the position that states are not immune to charges of infringement or free to violate the provisions of the Copyright Act at will. See *Mills Music, Inc. v. State of Arizona*, 591 F.2d 1278 (9th Cir. 1979).

[17] In addition to raising a "fair use" defense to plaintiff's infringement charge, defendants raise a First Amendment argument. Such claims have traditionally been handled under the "fair use"

> "a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner by the copyright." *Meeropol v Nizer*, 560 F.2d 1061, 1068 (2d Cir. 1977), *cert. denied* 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756 (1978), quoting from *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 306 (2d Cir. 1966) *cert. denied* 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967).

The doctrine has been used as a means of balancing the exclusive rights of a copyright holder with the interest of the public in the dissemination of information in areas of universal concern including art, science, history and industry.

The Copyright Act of 17 U.S.C. § 107 sets forth some of the factors which must be considered in determining the applicability of a "fair use" defense as follows:

> "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
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> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
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> (4) the effect of the use upon the potential market for or value of the copyrighted work."

In asserting the applicability of the doctrine in this case, defendants point out that the Testing Law was enacted in the public interest in order to make testing agencies more accountable to the public, in light of the

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doctrine. *Wainright Securities, Inc. v. Wall Street Transcript, supra.*

tremendous influence which standardized admissions tests can have on an individual's future. Furthermore, defendants contend that since there is no commercial purpose involved and since defendants do not intend to use plaintiff's tests for test purposes, that "fair use" should apply.

Plaintiff counters with several arguments in opposition to the application of the doctrine. First, plaintiff argues that it clearly cannot be said to be "fair use" to make public documents which have been deliberately restricted from public distribution. Plaintiff also contends that Sections 341 and 342 would involve copying almost the entire copyrighted work in each instance, therefore, negating the possibility for application of the doctrine. See *Rosemont Enterprises, Inc. v. Random House, Inc.*, *supra* at 316. Finally, plaintiff contends that disclosure under the Testing Law would virtually destroy the value of the tests and make impossible or render worthless continuation of the studies (a necessary pre-requisite for the preparation of future tests).

Although plaintiff's arguments against the application of the "fair use" doctrine have some merit, determination as to its use in this action must await a fuller development of the facts involved in light of defendants' public interest claim. As the Court indicated in *Meeropol v. Nizer*, *supra*, "The line which must be drawn between fair use and copyright infringement depends on an examination of the facts in each case," rather than "resort to any arbitrary rules or fixed criteria." 560 F.2d at 1068.

As previously indicated, in addition to the infringement claim, plaintiff alleges preemption of Sections 341 and 342 of the Testing Law by the federal Copyright Act and violation of its constitutional right to due process and equal protection. These claims also raise sufficiently serious claims to warrant further investigation.

Only a brief discussion with regard to those claims is necessary for the present.

Plaintiff's preemption argument is not without merit. While there is generally an assumption that an exercise of state police powers, as claimed by defendants, is not preempted by a federal statute, a clear indication to do so cannot be ignored by the Court. *Ray v. Atlantic Richfield Co., supra*, 17 U.S.C. § 301(a) shows a definite intent to preempt State laws which attempt to create the same rights as those created by § 106 of the Copyright Act. In *Mills Music, Inc. v. State of Arizona, supra*, at 1285, the Court stated that:

> "[a]lthough states may provide for additional protections for federal copyrights, a state may neither abrogate nor in any way diminish the federally granted and protected rights of a copyright holder."

See also *Goldstein v. California*, 412 U.S. 546, 93 S.Ct. 2303, 37 L.Ed.2d 163 (1973).

Nor can plaintiff's constitutional arguments be termed frivolous, even though the Court must uphold the constitutionality if possible to do so. Plaintiff alleges a valuable property interest in its tests and studies which will be taken without just compensation and virtually destroyed without due process of law.

While defendants assert that the Testing Law is a proper exercise of the State's police power, plaintiff contends that it is an invalid use because it is "not reasonably necessary to the effectuation of a substantial public purpose . . . [and] it has an unduly harsh impact upon [its] use of the property." *Penn Central Trans. Co. v. New York City*, 438 U.S. 104, 127, 98 S.Ct. 2646, 2661, 57 L.Ed.2d 631 (1978). A determination as to whether it is a proper exercise of police power can be made only after further investigation at trial.

Plaintiff's equal protection claim also requires further investigation. Plaintiff has alleged that the Law arbitrarily discriminates against it by exempting College Board and GRE achievement tests from the requirements

of Section 342. Although it has been suggested that the tests were exempted as not being used for admissions purposes, that supposition has been challenged.

Balance of Hardships

In the recent case of *Buffalo Courier-Express v. Buffalo Evening News, supra,* the Court stated that:

> "A 'balance of hardships tipping decidedly toward the party requesting the preliminary relief' must mean real hardship from the denial of relief *pendente lite* —not merely the showing of difficulty of measurement which may suffice to constitute 'irreparable damage' where a plaintiff shows probable success." 601 F.2d at 58.

Plaintiff has satisfied that test. If no relief from enforcement is granted by this Court, plaintiff will have the option of no longer giving the test in New York State, of giving the test in New York and complying with the law, or of giving the test in New York and refusing to comply with the law.

The hardship involved in not giving the test in New York is clear, not only as to plaintiff but to potential test subjects who are residents or students in New York and perhaps ultimately to the entire medical profession if plaintiff's contentions are valid.

If plaintiff gives the test in New York and complies with the law, test questions used in scoring and related studies must be disclosed. According to plaintiff, disclosure of the test questions will create serious harm in two major ways. First, disclosure will prohibit reuse of the questions which will, in plaintiff's opinion present a serious problem as to the science knowledge portions of the exam for which there are allegedly a limited number of potential questions. Second, since plaintiff uses scored questions for equating purposes rather than unscored questions which need not be disclosed and which are gen-

erally used for equating, plaintiff will have no way to insure comparability between tests in the future, thus destroying the value of the tests. Plaintiff also claims that if studies must be disclosed, it will no longer be able to do confidential studies for undergraduate institutions interested in how their graduates have done and will no longer be able to do internal studies which investigate the value of questions and are used in development of new questions.

The hardship in giving the test in New York and refusing to comply with the Law is evident since the Law provides for a $500 fine for each violation (Ed.Law § 346), and the possibility of an injunction action by the Attorney General for consistent violations. [Executive Law § 63(12)].

Defendants, however, claim that the balance of hardship tips not towards the plaintiff but towards the public in light of the strong public interest in disclosure of the tests and studies. While the public interest is clearly a consideration in determining the propriety of granting injunctive relief, the Court is not convinced that the harm to the public interest here would be greater if preliminary injunctive relief is granted than if denied, pending a determination of the action on the merits. The Court is aware that the Commissioner of Education of New York has serious misgivings concerning the Testing Law. He has made clear that he questions whether the Law will serve the purposes for which it was enacted,[18] that he fears that many testing agencies will stop giving the tests in New York State, as threatened, or will decrease the number of test administrations per year, and he is concerned that the price for taking the tests will increase drastically, all to the detriment of the citizens of New York State. Already there have been amendments pro-

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[18] One reason for enactment was the hope of being able to remove cultural biases from admissions tests.

posed to the Law, including one which would postpone the effective date.

While the State's purpose in enacting the Law may be a salutory example of a State protecting the interests of its citizens, that determination as to the merits of the Law as now written remain very much in the air at this time. That being the case, the Court cannot find that the public interest demands denial of injunction, nor the Court's opinion that the balance of hardships is decidedly in plaintiff's favor changed.

Irreparable Injury

Irreparable injury means "injury for which a monetary award cannot be adequate compensation [and] where money damages is adequate compensation a preliminary injunction will not issue." *Jackson Dairy, Inc. v. H. P. Hood & Sons, Inc.*, 596 F.2d 70, 72 (2d Cir. 1979).

Defendants claim that plaintiff's injuries can be adequately compensated in money damages. In so stating, defendants rely upon a statement in an affidavit submitted by plaintiff in which James Erdmann, plaintiff's Director of Educational Measurement and Research, estimated that it would cost plaintiff $200,000 in 1980 for question development, form construction, equating and other tasks essential to deal with the public disclosure requirements of the Law. If this was plaintiff's only allegation of damage, then clearly injunctive relief would be prohibited. However, as already discussed, plaintiff fears the actual destruction of the MCAT's value as an admission's test through disclosure by destruction of the ability to insure comparability between tests.[19] Also, plaintiff has indicated that it will no longer be able to do certain studies, including some done for the purpose of testing questions. Once plaintiff's test form or any of

[19] Plaintiff also points out that placement of unscored questions is extremely important and should not be revealed.

its studies are revealed, plaintiff asserts irreparable injury will have occurred.[20]

Defendants, however, claim that in order for plaintiff to be entitled to injunctive relief, it must show immediate harm which it cannot do since the first MCAT under the Law will not be given until April making disclosure unnecessary until the scores were sent out. Furthermore, defendants argue that since studies do not need to be filed until thirty days after completion, pursuant to Regulation 56.3(b) of the Commissioner, there could not possibly be an immediate threat justifying injunctive relief.

A preliminary injunction may not be issued where the alleged injury is remote or purely speculative. *State of New York v. Nuclear Reg. Com'n.*, 550 F.2d 745 (2d Cir. 1977). That is not the case here. Plaintiff will definitely be affected by the Law unless it decides not to give the test in New York, and even in making such a decision plaintiff will, in effect, be injured. Injury is not speculative, nor is it remote, since the damage is very likely to occur during the pendency of this action, the time period for which relief is now sought.[21]

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[20] Plaintiff also points out that where a prima facie case of copyright infringement has been established, a detailed showing of irreparable harm is not necessary. *Cf. Wainright Securities, Inc. v. Wall Street Transcript Corp., supra.* The Court did not make any specific findings with regard to plaintiff's infringement allegations, so the application of this rule is questionable but also unnecessary in light of the adequate showing of irreparable injury.

[21] Even though the first MCAT of the year is not scheduled to be given until April, there is no assurance that the action will no longer be pending then. "If MCAT determines that it cannot give the 1980 April MCAT in New York, it will have to begin notifying prospective examinees and undergraduate advisors through printed brochures, manuals, and other media of any changes in test center location no later than January 21, 1980." (Affidavit of Erdmann, *supra.*) In any event, plaintiff prepares studies on an ongoing basis and could complete one at any time during the pendency of the action.

The Court finds, therefore, that the plaintiff has demonstrated irreparable injury, and as previously indicated, grants plaintiff's motion for a preliminary injunction enjoining enforcement of Sections 341 and 342 as to this plaintiff during the pendency of this action.

SO ORDERED.

APPENDIX G

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, in the City of New York, on the 26th day of April, one thousand nine hundred and one.

Docket Number 90-7269, 90-7309

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff-Appellee,

-v-

MARIO CUOMO, *et al.*,
Defendants-Appellants.

A petition for rehearing containing a suggestion that the action be reheard in banc having been filed herein by Appellee Association of American Medical Colleges.

Upon consideration by the panel that heard the appeal, it is

Ordered that said petition for rehearing is DENIED.

It is further noted that the suggestion for rehearing in banc has been transmitted to the judges of the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

/s/ Elaine B. Goldsmith
ELAINE B. GOLDSMITH
Clerk

APPENDIX H

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

79-CV-730

(JUDGE MCCURN)

ASSOCIATION OF AMERICAN MEDICAL COLLEGES,
Plaintiff,

-against-

MARIO CUOMO, GOVERNOR OF THE STATE OF NEW YORK, *et al.*,
Defendants.

NOTICE OF APPEAL

[Filed Mar. 13, 1990]

SIR:

PLEASE TAKE NOTICE that the defendants in the above matter hereby appeal to the United States Court of Appeals for the Second Circuit, from the final order of judgment entered by the Court on February 13, 1990.

DATED: Albany, New York
March 12, 1990

Yours, etc.,

ROBERT ABRAMS

Attorney General of the
State of New York

/s/ David B. Roberts
DAVID B. ROBERTS, Assistant
Attorney General, of Counsel
Attorney for Defendants
The Capitol
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TO: ROBERT A. BURGOYNE, ESQ.
FULBRIGHT & JAWORSKI
Attorneys for Plaintiff
1150 Connecticut Ave., N.W.
Washington, D.C. 20036

APPENDIX I

Federal Rule of Civil Procedure 10

Rule 10. Form of Pleadings

(a) Caption; Names of Parties. Every pleading shall contain a caption setting forth the name of the court, the title of the action, the file number, and a designation as in Rule 7(a). In the complaint the title of the action shall include the names of all the parties, but in other pleadings it is sufficient to state the name of the first party on each side with an appropriate indication of other parties. * * * *

Federal Rule of Appellate Procedure 3

Rule 3. Appeal as of Right—How Taken

(a) Filing the Notice of Appeal. An appeal permitted by law as of right from a district court to a court of appeals shall be taken by filing a notice of appeal with the clerk of the district court within the time allowed by Rule 4. Failure of an appellant to take any step other than the timely filing of a notice of appeal does not affect the validity of the appeal, but is ground only for such action as the court of appeals deems appropriate, which may include dismissal of the appeal. Appeals by permission under 28 U.S.C. § 1292(b) and appeals in bankruptcy shall be taken in the manner prescribed by Rule 5 and Rule 6 respectively.

* * * *

(c) Content of the Notice of Appeal. The notice of appeal shall specify the party or parties taking the appeal; shall designate the judgment, order or part thereof appealed from; and shall name the court to which the appeal is taken. Form 1 in the Appendix of Forms is a suggested form of a notice of appeal. An appeal shall not be dismissed for informality of form or title of the notice of appeal.

* * * *

APPENDIX J

This appendix compiles certain post-*Torres* cases that have addressed the adequacy of notices of appeal. For the most part, it does not include the numerous cases that have rejected the use of "*et al.*," cases that dismissed parties from an appeal for unspecified failures to name appellants, cases that refused to review attorney sanctions because the appeals were in their clients' names, or cases that have considered whether *Torres* also applies to an appellant's failure to specify the interested appellees. Some cases appear in more than one category, and the various lists are not necessarily exhaustive. Additional decisions presumably exist that are unreported and not available through computer searches.

I. "*ET AL.*" CASES

A. *Cases In Which Et Al. Was Sufficient Because Only One Other Party*

Chandler v. Barncastle, 919 F.2d 23, 25 (5th Cir. 1990)

Pope v. Mississippi Real Estate Com'n, 872 F.2d 127, 129 (5th Cir. 1989)

But see Baucher v. Eastern Indiana Production Credit Ass'n, 906 F.2d 332, 333-34 (7th Cir. 1990) (*et al.* insufficient even though there was only one other party, the plaintiff's wife)

B. *Cases In Which Et Al. Was Sufficient Because Parent Was Representing Children*

Griffith v. Johnston, 899 F.2d 1427, 1429-30 (5th Cir.), *reh'g denied*, 904 F.2d 705 (5th Cir. 1990) (TABLE), *cert. denied*, 111 S. Ct. 712 (1991)

King v. Otasco, Inc., 861 F.2d 438, 442-43 (5th Cir. 1988)

C. *Cases In Which Et Al. Was Sufficient Because Named Party Was Class Representative*

Al-Jundi v. Estate of Rockefeller, 885 F.2d 1060, 1061 n.1 (2nd Cir. 1989)

Rendon v. AT & T Technologies, 883 F.2d 388, 398 n.8 (5th Cir. 1989)

II. CASES IN WHICH "*ET UX.*" WAS HELD SUFFICIENT

Milanovich v. Costa Crociere, S.p.A., —— F.2d —— (D.C. Cir. July 12, 1991) (per curiam) (TEXT IN WESTLAW, No. 90-7155)

Swager v. Texaco, Inc., 930 F.2d 35 (10th Cir. 1991) (TABLE, TEXT IN WESTLAW, No. 88-1781, 88-1834, 88-2745)

III. "GENERIC PHRASE" CASES

A. *Cases In Which Generic Phrases Were Held Insufficient*

Gonzalez-Vega v. Hernandez-Colon, 866 F.2d 519, 520 (1st Cir. 1989) ("plaintiffs Alfredo Gonzalez, et al.")

Marin-Piazza v. Aponte-Rogue, 873 F.2d 432, 433 (1st Cir. 1989) ("the codefendants in this action")

Pontarelli v. Stone, 930 F.2d 104, 108 (1st Cir. 1991) ("Plaintiffs in the above-entitled action")

Rosario-Torres v. Hernandez-Colon, 889 F.2d 314, 316-17 (1st Cir. 1989) (en banc) ("plaintiffs")

Barnett v. Petro-Tex Chem. Corp., 893 F.2d 800, 804-05 (5th Cir.) ("Plaintiffs above-named"), *cert. denied*, 110 S. Ct. 3274 (1990)

Heussner v. National Gypsum Co., 887 F.2d 672, 675 (6th Cir. 1989) ("Plaintiffs, in the captioned action"), *reh'g denied* (6th Cir. 1989, 1990)

Minority Employees of Tennessee Dept. of Employment Sec., Inc. v. State of Tennessee, Dept. of Employment Sec., 901 F.2d 1327, 1332 (6th Cir.) (en banc) ("plaintiffs in the above case"), *cert. denied sub nom. Davis v. Tennessee Dept. of Employment Sec.*, 111 S. Ct. 210 (1990)

Bigby v. City of Chicago, 871 F.2d 54, 56-57 (7th Cir. 1989) ("Plaintiffs and Intervening Plaintiffs")

Laidley v. McClain, 914 F.2d 1386, 1389 (10th Cir. 1990) ("plaintiffs in the above-styled case")

Cotton v. U.S. Pipe & Foundry Co., 856 F.2d 158, 161 (11th Cir. 1988) ("the named Plaintiffs herein, on behalf of themselves and all others similarly situated")

But see Hartford Cas. Inc. Co. v. Borg-Warner Corp., 913 F.2d 419, 423 (7th Cir. 1990) (generic term in body is sufficient when caption names all the appellants)

Tri-Crown, Inc. v. American Federal Sav. & Loan Ass'n, 908 F.2d 578, 579-80 (10th Cir. 1990) (notice sufficient when caption named all and body referenced caption ("Plaintiffs above-named"))

B. *Ninth Circuit Cases In Which Generic Phrases Were Held Sufficient*

Cammack v. Waihee, 932 F.2d 765 (9th Cir. 1991) ("Plaintiffs above-named" held to be adequate, even though caption listed only one plaintiff)

Graves v. Raypak, Inc., 895 F.2d 1417 (9th Cir. 1990) (TABLE, TEXT IN WESTLAW, No. 89-15916) (withdrawing prior order which had dismissed the appeals of certain unnamed appellants, and holding that "the term 'plaintiffs' . . . fairly indicates that all, not just some, of the plaintiffs were seeking to appeal")

Montes v. Thornburgh, 919 F.2d 531, 534 n.3 (9th Cir. 1990) ("defendants")

National Center for Immigrants' Rights, Inc. v. I.N.S., 892 F.2d 814 (9th Cir. 1989) ("defendants")

Zamora v. Hart, 902 F.2d 42 n.1 (9th Cir. 1990) (TABLE, TEXT IN WESTLAW, No. 88-15277) ("defendants")

But see Sauceda v. Washington Dept. of Labor & Indus., 917 F.2d 1216, 1218 (9th Cir. 1990) (where caption listed only certain plaintiffs, without the phrase "*et al.*,"

unlisted plaintiff was not an appellant despite use of phrase "plaintiffs, and each of them, hereby appeal" in the body of the notice)

C. *Cases In Which Modified Generic Phrases Were Held Sufficient*

In re San Juan Dupont Plaza Hotel Fire Litigation, 888 F.2d 940, 941-42 (1st Cir. 1989) (plaintiffs "through the Plaintiffs' Steering Committee" sufficient when PSC represented all of the plaintiffs)

Baylis v. *Marriott Corp.*, 906 F.2d 874, 876-77 (2nd Cir. 1990) ("all of the plaintiffs in this action")

Adkins (Clarence M.), Other Named Plaintiffs v. United Mine Workers of America, —— F.2d ——, 1991 WL 87360 at 4-5 (6th Cir. 1991) ("all of the Plaintiffs to this action as set out in the Complaint which has been filed herein as well as in all amendments thereto")

Board of Educ. of Muhlenberg County, Ky. v. U.S., 920 F.2d 370, 371 n.1 (6th Cir. 1990) (naming one, plus "the other 107 named Plaintiffs")

Gilbreath v. Cutter Biological, Inc., 931 F.2d 1320, 1322-23 (9th Cir. 1991) ("plaintiffs, as consolidated into this cause")

But see Storage Technology Corp. v. U.S. Dist. Court for Dist. of Colorado, 934 F.2d 244, —— (10th Cir. 1991) ("all the Defendants of record herein" insufficient when three complaints listed different defendants)

But see Santos-Martinez v. Soto-Santiago, 863 F.2d 174, 175-76 (1st Cir. 1988) ("all plaintiffs appeal" insufficient when some plaintiffs had withdrakn below, none were named in the body, and the only one named in the caption had withdrawn; appeal dismissed), *reh'g denied* (1st Cir. 1989)

IV. CASES IN WHICH CAPTION WAS HELD IRRELEVANT

Allen Archery, Inc. v. Precision Shooting Equip., Inc., 857 F.2d 1176 (7th Cir.), *reh'g denied* (7th Cir. 1988)

Bigby v. City of Chicago, 871 F.2d 54, 57 (7th Cir. 1989)

Barnett v. Stern, 909 F.2d 973, 977 (7th Cir. 1990)

V. CASES HOLDING THAT CAPTION MAY CLARIFY BODY

Barnett v. Petro-Tex Chemical Corp., 893 F.2d 800, 803-06 (5th Cir.) (party named only in caption could appeal), *reh'g denied* (5th Cir.), *cert. denied*, 110 S. Ct. 3274 (1990)

Minority Employees of Tennessee Dept. of Employment Sec., Inc. v. State of Tennessee, Dept. of Employment Sec., 901 F.2d 1327 (6th Cir.) (en banc) (party named only in caption could appeal), *cert. denied sub nom. Davis v. Tennessee Dept. of Employment Sec.*, 111 S. Ct. 210 (1990)

Mariani-Giron v. Acevedo-Ruiz, 877 F.2d 1114, 1115-16 (1st Cir. 1989) (party named in caption may appeal)

Samaad v. City of Dallas, 922 F.2d 216, 220 (5th Cir.) (party named in caption may appeal), *reh'g denied* (5th Cir. 1991)

Hartford Cas. Ins. Co. v. Borg-Warner Corp., 913 F.2d 419 (7th Cir. 1990) (caption relevant when no ambiguity between body and caption)

Tri-Crown, Inc. v. American Federal Sav. & Loan Ass'n, 908 F.2d 578, 579-80 (10th Cir. 1990) (notice sufficient when caption named all and body referenced caption ("Plaintiffs above-named"))

VI. CASES IN WHICH OMISSION WAS CURED BY OTHER DOCUMENTS THAT HAD BEEN FILED WITHIN THE TIME LIMIT FOR FILING A NOTICE OF APPEAL

Dura Systems, Inc. v. Rothbury Investments, Ltd., 886 F.2d 551, 553-55 (3d Cir.) (consent order), *reh'g denied* (3d Cir. 1989), *cert. denied*, 110 S. Ct. 844 (1990)

In re Highway Truck Drivers & Helpers Local Union No. 107, 888 F.2d 293, 296 n.4 (3d Cir. 1989) (amended notice of appeal)

In re Paoli R.R. Yard PCB Litigation, 916 F.2d 829, 837-38 (3d Cir.) (letter from counsel), *reh'g denied* (3d Cir. 1990), *cert. denied sub nom. General Elec. Co. v. Knight*, 111 S. Ct. 1584 (1991)

Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 665-66 (3d Cir. 1990) (attorney appearance form and civil appeal information statement)

Brotherhood of Ry. Carmen (Div. of TCU) v. Atchison, Topeka & Santa Fe Ry. Co., 894 F.2d 1463, 1464-65 (5th Cir.) (supporting memorandum), *cert. denied*, 111 S. Ct. 131 (1990)

Warfield v. Fidelity & Deposit Co., 904 F.2d 322, 325 (5th Cir. 1990) (motion to stay appeal)

Depineda v. Garcia, 931 F.2d 62 (10th Cir. 1991) (TABLE, TEXT IN WESTLAW, No. 90-1333) (appellate brief))

Haas v. Farmers Ins. Group, 930 F.2d 33 (10th Cir. 1991) (TABLE, TEXT IN WESTLAW, No. 90-7084) (docketing statement)

Hubbert v. City of Moore, Okl., 923 F.2d 769, 772 (10th Cir. 1991) (docketing statement)

Riggs v. City of Albuquerque, 916 F.2d 582, 584 n.1 (10th Cir. 1990) (amended notice of appeal), *cert. denied*, 111 S. Ct. 1623 (1991)

But see Pontarelli v. Stone, 930 F.2d 104 (1st Cir. 1991) (refusing to grant extension of time to allow appellants to amend their notice)

VII. CASE IN WHICH CERTIORARI HAS BEEN GRANTED

Board of Governors of State Colleges & Universities v. Akin, 840 F.2d 1371 (7th Cir.), *vacated*, 109 S. Ct. 299 (1988) (remanded in light of *Torres*)

VIII. CASES IN WHICH CERTIORARI WAS DENIED

The certiorari petitions filed in the following cases each included at least one *Torres* issue.

Appeal of Jessup, 856 F.2d 183 (3d Cir. 1988) (TABLE), *cert. denied sub nom. Jessup v. United States*, 488 U.S. 1005 (1989)

Dura Systems, Inc. v. Rothbury Investments, Ltd., 886 F.2d 551, 553-55 (3d Cir.), *reh'g denied* (3d Cir. 1989), *cert. denied*, 110 S. Ct. 844 (1990)

Kowaleski v. Director, Office of Workers' Compensation Programs, U.S. Dept. of Labor, 879 F.2d 1173 (3d Cir.), *reh'g denied* (3d Cir. 1989), *cert. denied*, 110 S. Ct. 1114 (1990)

Sutton v. National Intergroup Inc., —— F.2d —— (4th Cir. 1989, *cert. denied*, 110 S. Ct. 730 (1990)

Barnett v. Petro-Tex Chemical Corp., 893 F.2d 800, 803-06 (5th Cir.), *reh'g denied* (5th Cir.), *cert. denied*, 110 S. Ct. 3274 (1990)

Griffith v. Johnston, 899 F.2d 1427, 1429-30 (5th Cir.), *reh'g denied*, 904 F.2d 705 (5th Cir. 1990) (TABLE), *cert. denied*, 111 S. Ct. 712 (1991)

McLemore v. Landry, 898 F.2d 996, 999-1000 (5th Cir.), *cert. denied sub nom. River Villa Partnership v. Sun Belt Federal Bank*, 111 S. Ct. 428 (1990)

Minority Employees of Tennessee Dept. of Employment Sec., Inc. v. State of Tennessee, Dept. of Employment Sec., 901 F.2d 1327, 1332 (6th Cir.) (en banc), *cert. denied sub nom. Davis v. Tennessee Dept. of Employment Sec.*, 111 S. Ct. 210 (1990)

Kunkle v. Fulton County Board of Commissioners, 922 F.2d. 841 (6th Cir. 1990) (TABLE), *cert. denied*, 111 S. Ct. 959 (1991)

Pride v. Venango River Corp., 916 F.2d 1250, 1253 (7th Cir. 1990), *cert. denied*, 111 S. Ct. 1696 (1991)

Appeal of District of Columbia Nurses' Ass'n, 854 F.2d 1448 (D.C. Cir. 1988), *cert. denied*, 491 U.S. 906 (1989)

Mayeske v. International Ass'n of Fire Fighters, 905 F.2d 1548, 1549-50 n.1 (D.C. Cir.), *cert. denied*, 111 S. Ct. 347 (1990)